TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

[redacted] 1920

No. [redacted]181

AMERICAN STEEL FOUNDRIES, PETITIONER,

vs.

JAMES T. NEWTON, COMMISSIONER OF PATENTS.

[redacted]

(27,176)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1919.

No. 421.

AMERICAN STEEL FOUNDRIES, PETITIONER,

vs.

JAMES T. NEWTON, COMMISSIONER OF PATENTS.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., JANUARY 26, 1920.

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1 Court of Appeals of the District of Columbia.

Patent Appeal Docket, No. 1218.

In the Matter of the Application of AMERICAN STEEL FOUNDRIES.

In the Court of Appeals *for* the District of Columbia.

No. 1218, Patent Appeal Docket.

In re Application of AMERICAN STEEL FOUNDRIES. Serial No. 103,942. Filed May 19, 1917.

For Trade Mark "Simplex."

To the Court of Appeals of the District of Columbia:

Your petitioner, American Steel Foundries, a corporation of the State of New Jersey, and having an office and place of business at Chicago, in the State of Illinois, respectfully represents that it is the owner and proprietor of the trade-mark "Simplex," as identified by the above entitled application for registration of the said trade-mark; that on the 19th day of May, A. D. 1917, in the manner prescribed by law, it presented its application to the Patent Office praying that a certificate of registration be issued to it for the said trade-mark; that such proceedings were had in said office upon said application; that on the 23rd day of February, 1918 it was rejected by the Commissioner of Patents and a certificate of registration for said trade-mark was refused it; that on the 29th day of March, 1918 your petitioner pursuant to Sections 4912 and 4913, Revised Statutes of the United States, gave notice to the Commissioner of Patents of its appeal to this Honorable Court, from his refusal to issue a certificate of registration to it for said trade-mark upon said application, as aforesaid, and filed with him in writing the following reasons of appeal:

"1. The Commissioner of Patents erred in refusing to register applicant's trade-mark, as set forth in its said application above identified.

2. The Commissioner of Patents erred in holding that the word "Simplex," as used by applicant, is merely the name of the corporation Simplex Electric Heating Company.

3. The Commissioner of Patents erred in holding that the word "Simplex" is descriptive.

2 4. The Commissioner of Patents erred in holding that the word "Simplex" is a distinguishing part of the name of a corporation Simplex Electric Heating Company.

5. The Commissioner of Patents erred in holding that the case of Simplex Electric Heating Company v. Ramey Company, 232 O. G. 1259 is relevant and controlling in this application.

6. The Commissioner of Patents erred in holding that the ruling in ex parte Simplex Electric Heating Company, 123 Ms. D. 114 has any application in this case.

7. The Commissioner erred in not taking into account the fact that the goods for which applicant's mark is sought to be registered are clearly distinguishable over the products of the Simplex Electric Heating Company, and that there is no possibility of a confusion of goods arising between the products of this applicant and products of the Simplex Electric Heating Company.

8. The Simplex Electric Heating Company does not have exclusive right to the use of the word "Simplex" because of its long years of acquiescence in the use of the same word by the Simplex Railway Appliance Company, the predecessor of this applicant.

9. The decision of the Commissioner of Patents is contrary to the Statutes governing the registration of trade-marks.

10. The Commissioner erred in refusing registration of the arbitrary word "Simplex" as a trade-mark for the goods recited when the Examiner of Trade-Marks has ruled that the mark is not anticipated."

That the Commissioner of Patents has furnished it with a certified transcript of the records and proceedings relating to said application for registration of the trade-mark, which transcript is filed herewith and is to be deemed and taken as a part hereof.

Wherefore, your petitioner prays that its said appeal may be heard upon and for the reasons assigned therefor to the Commissioner, as aforesaid, and that said appeal may be determined and the decision of the Commissioner be revised and reversed that justice may be done in the premises.

AMERICAN STEEL FOUNDRIES,
By WILKINSON & HUXLEY,
Attorneys.

2—390.

United States of America,
Department of the Interior,
United States Patent Office.

To all to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the Records of this Office of the Record for the Court of Appeals of the District of Columbia, in the matter of the Pending Application for the Registration of a Trade-Mark by American Steel Foundries, Filed May 19, 1917, Serial Number 103,942, for Brake Rigging, etc.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this 6th day of May, in the year of our Lord one thousand nine
3 hundred and eighteen and of the Independence of the United States of America the one hundred and forty-second.

[Seal Patent Office, United States of America.]

F. W. H. CLAY,
Acting Commissioner of Patents.

(Here follows diagram marked page 3.)



Mail Room.
May 19, 1917.
U. S. Patent Office.

Serial No. 103,942. Paper No. O. K.

O. K.

Application.

Case No. 17175.

Petition.

To the Commissioner of Patents:

The undersigned herewith presents a drawing and five specimens of its Trade Mark and requests that the same, together with the accompanying Statement and Declaration may be registered in the United States Patent Office, in accordance with the law in such cases made and provided.

And it hereby appoints Wilkinson & Huxley, a firm composed of George L. Wilkinson and Henry M. Huxley, 1604 First National Bank Building, Chicago, Illinois, (registration No. 10,831), its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

AMERICAN STEEL FOUNDRIES,
By R. P. LAMONT,
President.

Case No. 17175.

Canceled Jan. 25, '18.

Statement.

To all whom it may concern:

Be it known that the American Steel Foundries, a corporation duly organized and existing under and by virtue of the laws of the State of New Jersey and having its principal office and place of business in Chicago, Illinois, has adopted for its use as a trade mark the word "Simplex," shown in the accompanying drawing for brake rigging, brake heads, brake beams, brake shoes, brake hangers and

19, Vehicles, not including engines.

Per A. clasp brakes, in Class A [14, Metal and Metal Castings and Forgings].*

[*Words and figures enclosed in brackets erased in copy.]

The Trade Mark has been continuously used in the business of the said corporation since on or about April 16, 1917.

The Trade Mark is applied to the goods by casting the same thereon.

AMERICAN STEEL FOUNDRIES,
By R. P. LAMONT,
President.

[Matter enclosed between rules erased in copy.]

Case No. 17175.

Canceled Jan. 25, 1918.

Declaration.

STATE OF ILLINOIS,
County of Cook, ss:

Robert P. Lamont, being duly sworn, deposes and says that he is President of the corporation named in the foregoing statement; that he believes the foregoing statement to be true; that he believes said corporation is the owner of the trade mark sought to be registered; that no other firm, person, corporation or association, to the best of his knowledge and belief, has the right to use said trade mark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade mark is used by said corporation in commerce among the several states of the United States; that the description and drawing truly represents the trade mark sought to be registered and that the photographs show the trade mark as actually used upon the goods.

ROBERT P. LAMONT.

Subscribed and sworn to before me, this 14th day of May, A. D. 1917.

[SEAL.] ALICE McGARRY,
Notary Public.

Commission expires April 24, 1921.

[Matter enclosed between rules erased in copy.]

Paper No. 1—Rej.

July 19, 1917.

Wilkinson & Huxley, 1st National Bank Building, Chicago, Ill.:

American Steel Foundries. For Trade-mark. Filed May 19, 1917. Serial No. 103,942.

Applicant is advised that the goods are classified in Class 19, Vehicles, not including engines, and the class should be so set up.

Registration is refused on the ground that the mark is descriptive. Attention is called to the ruling in ex parte Simplex Electric Heating Co., 123 MS. D., 114.

A search in Class 19 fails to show that the mark is anticipated.

J. CARNES.

("Simplex.")

D. W. S.

U. S. Patent Office,
Oct. 27, 1917,
Trade-Marks and Designs.

Serial No. 103,942. Paper No. 2.

Am'd't & Arg't.

United States Patent Office.

Room 163.

In re Application of American Steel Foundries. Trade-mark "Simplex." Filed May 19, 1917. Serial Number 103,942.

CHICAGO, October 25, 1917.

Amendment.

Hon. Commissioner of Patents, Washington, D. C.:

SIR: In response to Official communication of July 19th, 1917, please amend the above applications as follows:

Last line, first paragraph of the statement, *cancel "Class 14, Metal and Metal Castings and Forgings"* and *insert Class 19, Vehicles, not including Engines.*

6 *Remarks.*

It is not seen wherein the word "Simplex" can in any sense be considered as descriptive of the subject-matter sought to be covered by this application and particularly in view of the fact that the word "Simplex" has been registered many times and has not been heretofore considered a descriptive word. Applicant has secured registration No. 73,250 dated April 6, 1909, for Railway Car Couplings and the same word was registered by the Simplex Railway Appliance Company, a company which has been acquired by the present applicant, as No. 81,752, October 24, 1911, for Railway Car Bolsters, since the date of issuance of the certificate of registration. Some sixty other registrations of the word "Simplex" have been recorded in the

Patent Office, some of them going back as far as the year 1859. (Simplex Co. v. Ramey Co., 232 O. G. 1259). As stated in Huenefeld, 100 O. G. 1329—

"The prohibition against the registration of descriptive words as trade-marks applies only to those words which state or define some quality or characteristic of the article, or designated class, grade, style, or quality, or the ingredients of which it is composed".

It is not understood how the use of the word "Simplex" can convey to the mind any of the qualities or characteristics or in any manner be descriptive of the goods sought to be covered by this application. It is an ordinary word adopted directly into our language from the Latin, just as hundreds of other words have come into our language by common usage, and does not even by origin or analogy convey an idea of any physical property or any other characteristic of the goods. Neither does it convey to the mind any idea of class, grade, style or quality of the articles sought to be covered by the application, nor of the composition or ingredients of the said articles. It is contended, therefore, that in view of these facts and the fact that the word has so often been registered heretofore, that the word "Simplex" is clearly registrable to the applicant in this application.

The Examiner has called attention to the ruling in ex parte Simplex Electric Heating Co. 123 MS. D. 114. An examination of this decision discloses that it was rendered upon a petition praying that the Examiner of Trade-Marks be instructed to reject any application to register the word "Simplex" for any party other than the Simplex Electric Heating Company, and cites in support the case of Asbestone Company vs. Philip Carey Mfg. Co. 41 App. D. C. 507. It is not seen how it is possible to consider this application as falling within the prohibition of either one of the decisions cited above.

This application is clearly distinguished from the "Asbestone" case. In this case The Philip Carey Mfg. Company filed an application for registration of the word "Asbestone" as a trade-mark for hard asbesto- boards. An opposition was filed by the Asbestone Company, a corporation formed for the purpose of the manufacture and sale of non-heat-conducting and fire-proofing materials of
7 asbestos qualities as the goods sought to be protected by the Carey Company. The opposition was sustained by the Courts of Appeals D. C. holding that a corporation has the same right to the protection of the property right in its name as an individual has to the use and enjoyment of his name the same as he has to any other species of property, all of which is, of course, perfectly clear and logical. However, the law does not give to Smith, an individual engaged in the boot and shoe business and trading and doing business under his individual name, such an exclusive right to the use of his name, as would prevent his neighbor Smith who is engaged in the drug business from acquiring property rights in the use of his name for the promotion of his drug business. Whenever the reason for a rule ceases, then the rule itself ceases.

The case of Simplex Electric Heating Company v. Ramey Company, decided by the Court of Appeals D. C. April 23, 1917, and re-

orted in 234 O. G. 793, is practically the same as the Asbestone ase, with the addition that the Ramey Company claimed certain ights under the word "Simplex" by reason of having used it for a eriod of approximately a year prior to the filing of its application or registration, and, as applicant understands, this decision is the asis of the opinion cited by the Examiner in the Office action of uly 19, 1917, as well as the "Asbestone" case. The articles of manufacture involved pertained to merchandise of the same descriptive qualities and also involved the date of use of the word "Simplex" and the date of manufacture of its products by the Simplex Electric Heating Company which were carried back through this company and certain other prior organized companies to about the year 1896. The Assistant Commissioner held in his opinion upon the same matter that there was not sufficient proof that the Simplex Electric Heating Company was the owner of the good will of the business of the original firm or the right to its trade mark as there was no assignment or other written evidence offered, and the only oral evidence offered was the bare and uncertain testimony of one witness not a party to the transfer. In view of the fact that the Ramey Company only claimed use since 1913, and the use by the Simplex Heating Company ante-dated this date by a long period of time, the Court apparently did deem it necessary to fix the exact date, and said:

"The business of the Simplex Electric Heating Company was started when the American Electric Heating Company accumulated some two or three hundred patents and started into manufacture about 1896. The concern was not successful and the business was taken over in 1898 by the Simplex Electrical Company * * *. Under this administration the business was considerably developed and extended to such an extent that in 1902 the Simplex Electric Heating Company was incorporated and continued the business from that point to the present time".

The present applicant has been using the word "Simplex" as a trade-mark for railway car couplings since June 1, 1907, (as shown by Registration No. 73,250, April 6, 1909), and for railway car bolsters since September 30, 1913, when it acquired from the Simplex Railway Appliance Company all of its property, assets, good-
8 will, and other mineral and chemical substances, which materials were of the same general class and possessed the same general descriptive — etc., which said company had used the word "Simplex" as a trade-mark for railway car bolsters since August 1, 1897, as shown by Registration No. 81,752, dated May 2, 1911, and as a matter of fact had used the word in the promotion of its railway car accessory business for something over a year prior to this time.

It will thus be seen that this applicant has at the present time and has had for long years past certain trade-mark rights for a part of its products and is seeking by this application to secure the same protection for other of its products, namely, brake rigging, brake beams, etc., all of which come within its general lines of car accessories and parts. These products have nothing in common with electrical goods or appliances, the market is entirely different, they are not

goods of the same descriptive qualities, there is no possible chance of confusion arising and no possibility of conflict between the prod-u-ts of this applicant and those of the Simplex Electric Heating Company. Furthermore, both of the above cases are lacking in any prior establishment of the use of the trade-mark such as there is in the present case, which is sufficient in and of itself to take this case out of the rule laid down in the above decisions.

And, furthermore, the opinion of the Court, when studied and analyzed closely, does not afford a basis for any such broad interpretation as that given by the Examiner, and as contended for by the Simplex Electric Heating Company in its petition, the decision upon which is cited by the Examiner. The Court says:

"There is some difficulty attending these questions of classification. A thing may not be the same and yet of the same general description and used for similar purposes. In this case the corporate name which is widely advertised for electrical goods caused persons to suppose that these cleaners were the product of the Simplex Company. With the enormous range afforded for the selection of trade-mark names, it is not unreasonable to suspect that this trade-mark was adopted for the purpose of obtaining the benefit of the wide advertising that had been done by the Simplex Company. In such a case the benefit of any doubt in regard to the classification should be given to the one who has used, developed and advertised the mark and given it trade value."

It seems clear that the Court in rendering its opinion had in mind that the goods involved were of the same descriptive qualities, particularly when the Court states that there is some difficulty attending these questions of the classification of goods, but the benefit of any doubt in regard to classification should be given in such a case to the one who has used, developed, and advertised the mark and given it its trade value. These words indicate clearly that the question of similarity or difference between the goods of the parties was deemed an essential point in the decision of the case and that therefore had the goods of the two parties been, in the opinion of the Court, of quite different distinctive qualities, the decision would have been different;

9 at any rate, the decision affords no ground for a contrary conclusion. Applying the above-quoted statement from the opinion of the Court, we do not believe the Examiner will have any difficulty in seeing his way clear to pass this application to publication.

Respectfully,

AMERICAN STEEL FOUNDRIES,
By WILKINSON & HUXLEY,
Attorneys.

Paper No. 3—Rej.

Nov. 2, 1917.

Wilkinson & Huxley, 1st National Bank Building, Chicago, Ill.:

American Steel Foundries. For Trade-mark. Filed May 19, 1917. Ser. No. 103,942.

Responsive to the communication filed Oct. 27, 1917.

Registration is again refused on the grounds stated in the first office letter of July 19, 1917; the decision therein cited is controlling on the examiner.

M. W. MILBURN,
Examiner.

D. W. S.

Docket Clerk,
Nov. 21, 1917,
U. S. Patent Office.

Serial No. 103,942, Paper No. 4.

$15, C'k, Rec'd Nov. 21, 1917. D. C. C., U. S. Pat. Office.

In the United States Patent Office.

Room 163.

In re Application of American Steel Foundries. Trade-mark "Simplex." Serial No. 103,942. Filed May 19, 1917.

Hon. Commissioner of Patents, Washington, D. C.

SIR: Applicant hereby appeals to the Commissioner in person from the action of the Examiner of trade-marks, who, on November 2, 1917, a second time refused registration of its application, above identified, for the trade-mark "Simplex," and tenders herewith a check to the order of the Commissioner of Patents for $15.00, amount of the appeal fee.

An oral hearing on this appeal is desired.

AMERICAN STEEL FOUNDRIES,
By WILKINSON & HUXLEY,
Attorneys.

10 U. S. Patent Office,
Nov. 30, 1917,
Mailed.

6.

In the United States Patent Office.

Application of American steel Foundries. For Trade-mark. Filed May 19, 1917. Serial No. 103,942. Attorney-, Wilkinson & Huxley.

Before the Commissioner on Appeal.

Examiner's Statement.

This is an appeal from the refusal to register the word "Simplex" as a trade-mark for brake rigging, brake heads, etc. Registration is refused following the ruling of the Assistant Commissioner in the case of in re Simplex Electric Heating Company (123 Ms. D. 114) which ruling is considered as controlling upon the Examiner.

W. I. HOUSTON,
Acting Ex'r.

H. H.

Nov. 30, 1917.

Mail Room,
Jan. 25, 1918,
U. S. Patent Office.

Serial No. 103,942. Paper No. 7.

Sub. St'm't and Decl'n.

Case No. 17,175.

Statement.

To all whom it may concern:

Be it known that the American Steel Foundries, a corporation duly organized and existing under and by virtue of the laws of the State of New Jersey and having its principal office and place of business in Chicago, Illinois, has adopted for its use as a trade-mark the word "Simplex", shown in the accompanying drawing for brake rigging, brake heads, brake beams, brake shoes, brake hangers and clasp brakes, in Class 19, vehicles, not including engines.

Sub. St'm't.

The trade-mark has been continuously used in the business of the said corporation and its predecessors since on or about August 1st, 1897.

The trade-mark is applied to the goods by casting or forg-
11 ing the same thereon, or by attaching a plate containing the trade-mark to the goods or some part thereof.

AMERICAN STEEL FOUNDRIES,
By R. P. LAMONT, *President.*

Case No. 17,175.

Declaration.

STATE OF ILLINOIS,
County of Cook, ss:

Robert P. Lamont, being duly sworn, deposes and says that he is President of the Corporation named in the foregoing statement; that he believes the foregoing statement to be true; that he believes said corporation is the owner of the trade mark sought to be registered; that no other firm, person, corporation or association, to the best of his knowledge and belief, has the right to use said trade mark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive;

Sub. Decl'n. that said trade mark is used by said corporation in commerce among the several states of the United States; that the description and drawing truly represents the trade mark sought to be registered and that the photographs show the trade mark as actually used upon the goods.

ROBERT P. LAMONT.

Subscribed and sworn to before me, this 8th day of January 1918.
[SEAL.]
ALICE McGARRY,
Notary Public.

Commission expires April 24, 1921.

Serial No. 103,942, Paper No. 8.

Recorded, Vol. 124, Page 6.

Hearing, Dec. 11, 1917. G. R. S.

In the United States Patent Office.

Ex Parte AMERICAN STEEL FOUNDRIES.

Application for Registration of Trade-mark.

Appeal.

Trade-mark for Brake Rigging, etc.

Application filed May 19, 1917. No. 103,942.

Messrs. Wilkinson & Huxley for applicant.

The applicant, the American Steel Foundries, a corporation of New Jersey, appeals from a refusal to register its trade-mark
12 "Simplex" for brake riggings. The refusal was based apparently on the ground that the mark consists merely in the name of a corporation,—although the examiner in terms specifically refused registration "on the ground that the mark is descriptive," calling attention to the ruling in *ex parte* Simplex Electric Heating Co., 123 MS. D., 114.

That decision set forth that there was of record in this office proof of incorporation of a concern called the "Simplex Electric Heating Co." in Massachusetts in the year 1902, and previous to that there was a corporation called the "Simplex Electric Company," incorporated March 16, 1895. This office is also informed of the existence of the Simplex Electric Company, a firm in Boston, at least as early as October 28, 1890, which on that date registered a certain trade-mark (#18,552) consisting of the word "Simplex" for insulated wire. The decision relied on by the examiner goes on to relate that the Court of Appeals of the District of Columbia had held in substance that "Simplex" was the distinguishing part of the names of those corporations, and that for that reason the word "Simplex" was not registrable as a trade-mark; wherefore the petition of the Simplex Electric Heating Company for instructions to the examiner of trade-marks to reject any application for registration of "Simplex" as a trade-mark was granted.

The present applicant shows that it is the successor of the Simplex Railway Appliance Company, which was incorporated in Illinois on July 30, 1897, and, further, that both the applicant and its predecessor, the Simplex Railway Appliance Company, have heretofore registered the trade-mark "Simplex;" the applicant in 1909 for car

couplings (#73,250), and its predecessor in 1911 for car bolsters (#81,752). In the latter registration continuous use since August 1, 1897, is claimed, that being the same date claimed by the present applicant for "Simplex" brake rigging.

This is an *ex parte* proceeding. The applicant contends that the rights of the Simplex Electric Heating Company should be inquired into only in an opposition; also that the goods of the applicant are clearly distinguished from all products of the Simplex Electric Heating Company, and that the word "Simplex" has a wide and varied use both as a trade-mark and as the name of a corporation. The applicant also asserts that the Simplex Electric Heating Company does not have the exclusive right to the use of the word "Simplex" as its name because of the universal adoption and use of the same word by many other companies. These contentions may all be sound; but, if it may be said that the word "Simplex" is, in the language of the statute, "merely the name of* a corporation*," which the Court has held to be the case, then it is entirely immaterial whether the goods of the parties are similar or not. The statute at this point makes no reference whatever to the goods for which the name is used as a trade-mark. It is probably true, as argued, that there is no real ground for refusing registration of any mark except the single ground that to do so would invade the rights of somebody else. But I see no escape from the conclusion that to register "Simplex" as a trade-mark for brake rigging (or for strawberry jam, or any goods whatever) would invade the rights of the Simplex Electric Heating Company, because that corporation has the sole right to use its name in trade.

13 The contention that the public previously had such rights in the word "Simplex" that the Simplex Electric Heating Company could not lawfully have appropriated the name to itself as its own, was fully developed in Simplex Electric Heating Company vs. Ramie Co., 232 O. G., 1259, at page 1261, and indeed it is therein mentioned that there had been a previous "Simplex" company, namely the Simplex Machine Company, incorporated in New York in 1884. Nevertheless the Court of Appeals reversed that decision (243 O. G., 793, and 7 T. M. R., 266), and apparently intimated by silence that in the view of the statute it made no difference whether the Simplex Electric Heating Company had a right to adopt and segregate the name.

Verbally it is argued that the court having taken such particular pains to show that the goods of the parties in that case were similar enough to cause confusion, indicates that the court considered the trade to be material to the question of use of a corporation's name. But that discussion was directed to another ground of rejection in that case and not to the matter of the corporate name. I am inclined to agree with this applicant's contention that the "mere name" referred to in the statute means a name to which the corporation has some claim as to its own property; but as I understand it the Court has held that this is the case with "Simplex," the name of the Simplex Electric Heating Company. Therefore, under the Court's con-

struction of the wording of the statute the applicant's mark must be refused registration; and the examiner's ruling is sustained.

F. W. H. CLAY,
Assistant Commissioner.

February 23, 1918.

Docket Clerk.
Mar. 29, 1918.
U. S. Patent Office.

Mail Room.
Mar. 29, 1918.
U. S. Patent Office.

Serial No. 103, 942. Paper No. 10.

In the United States Patent Office.

In re Application of American Steel Foundries. Serial No. 103,942.

Filed May 19, 1917.

For Trade-mark "Simplex."

Hon. Commissioner of Patents, Washington, D. C.

SIR:

You are hereby notified of the appeal of the undersigned, to the Court of Appeals of the District of Columbia from your decision rendered on or about the 23rd day of February, 1918, rejecting the above entitled application and refusing to register the word "Simplex" as a trade-mark, as set forth in said application. The following are assigned as reasons of appeal.

1. The Commissioner of Patents erred in refusing to register applicant's trade-mark, as set forth in its said application above identified.

14 2. The Commissioner of Patents erred in holding that the word "Simplex" as used by applicant, is merely the name of the corporation Simplex Electric Heating Company.

3. The Commissioner of Patents erred in holding that the word "Simplex" is descriptive.

4. The Commissioner of Patents erred in holding that the word "Simplex" is a distinguishing part of the name of a corporation Simplex Electric Heating Company.

5. The Commissioner of Patents erred in holding that the case of Simplex Electric Heating Company v. Ramey Company, 232 O. G. 1259 is relevant and controlling in this application.

6. The Commissioner of Patents erred in holding that the ruling in ex parte Simplex Electric Heating Company, 123 Ms. D. 114 has any application in this case.

7. The Commissioner erred in not taking into account the fact that the goods for which applicant's mark is sought to be registered

are clearly distinguishable over the products of the Simplex Electric Heating Company, and that there is no possibility of a confusion of goods arising between the products of this applicant and products of the Simplex Electric Heating Company.

8. The Simplex Electric Heating Company does not have exclusive right to the use of the word "Simplex" because of its long years of acquiescence in the use of the same word by the Simplex Railway Appliance Company, the predecessor of this applicant.

9. The decision of the Commissioner of Patents is contrary to the Statutes governing the registration of trade-marks.

10. The Commissioner erred in refusing registration of the arbitrary word "Simplex" as a trade-mark for the goods recited when the Examiner of Trade-Marks has ruled that the mark is not anticipated.

AMERICAN STEEL FOUNDRIES,
By WILKINSON & HUXLEY,
Attorneys.

Docket Clerk.
Apr. 10, 1918.
U. S. Patent Office.

103,942—11.

In the United States Patent Office.

In re Application of American Steel Foundries. Serial No. 103,942
Filed May 19, 1917.

For Trade-mark "Simplex."

Petition.

Hon. Commissioner of Patents, Washington, D. C.

SIR:

The applicant herein prays that in preparing the transcript of the proceedings in the matter of the appeal of the above application to the Court of Appeals for the District of Columbia a certified copy of
the articles of incorporation of the Simplex Electric Heating
15 Company be made a part of the transcript of the record of the proceedings before the Patent Office for use upon the hearing before the Court of Appeals before the District of Columbia, and herewith presents with this petition a certified copy of the articles of incorporation of the said Simplex Electric Heating Company.

AMERICAN STEEL FOUNDRIES,
By WILKINSON & HUXLEY,
Attorneys.

Petition granted [Approved]* Apr. 10 1918.
F. W. H. CLAY,
Assistant Commissioner.

[*Words and figures enclosed in brackets erased in copy.]

Docket Clerk.
Apr. 10, 1918.
U. S. Patent Office.

103,942—12.

We, George U. Crocker, President, Charles A. Morss, Jr., Treasurer, and John Wells Morss, Albert R. Whittier and Everett Morss being a majority of the Directors of Simplex Electric Heating Company in compliance with the requirements of the twentieth section of chapter one hundred and ten of the Revised Laws, do hereby certify that the following is a true copy of the agreement of association to constitute said Corporation, with the names of the subscribers thereto:—

"We, whose names are hereto subscribed, do, by this Agreement, associate ourselves with the intention to constitute a Corporation according to the provisions of the one hundred and tenth chapter of the Revised Laws of the Commonwealth of Massachusetts.

The name by which the Corporation shall be known is Simplex Electric Heating Company.

The Corporation is constituted for the purpose of manufacturing, installing, buying, selling and in any way dealing in all kinds of appliances, machinery and supplies for electric heating and other electrical purposes, also of manufacturing, buying, selling and in any way dealing in wire, metals, enamel, india rubber and any substitutes therefor, and manufactures of which one or more of said articles may form a part; and further for the purpose of transacting such other business as may be incidental to the foregoing.

The place within which the Corporation is established or located is the City of Boston within said Commonwealth.

The amount of its capital stock is Eighty thousand ($80,000).

The par value of its shares is One Hundred (100).

The number of its shares is Eight Hundred (800).

In witness whereof, we have hereunto set our hands, this second day of July in the year nineteen hundred and two.

GEORGE U. CROCKER.
EVERETT MORSS.
CHAS. A. MORSS, Jr.
ALBERT R. WHITTIER.
JOHN WELLS MORSS.

16 That the first meeting of the subscribers to said agreement was held on the tenth day of July i nthe year nineteen hundred and two.

In witness whereof, we have hereunto signed our names, this tenth day of July in the year nineteen hundred and two.

GEORGE U. CROCKER,
President.
EVERETT MORSS,
Vice Pres't.
CHAS. A. MORSS, Jr.,
Treas.
ALBERT R. WHITTIER,
JOHN WELLS MORSS.

THE COMMONWEALTH OF MASSACHUSETTS.
Suffolk, ss:

Boston, July 10, 1902.

Then personally appeared the above-named George U. Crocker, President, Charles A. Morse, Jr., Treasurer, and John Wells Morse, Albert R. Whittier and Everett Morse, Directors and severally made oath that the foregoing certificate, by them subscribed, is true to the best of their knowledge and belief.

Before me,

CLIFT ROGERS CLAPP,
Justice of the Peace.

Simplex Electric Heating Company.

Fee, $40.00, paid.

Certificate of Organization.

(Full Form.)

Revised Laws, Chap. 110, Sect. 20.

Filed in the office of the Secretary of the Commonwealth, July 14, 1902.

I hereby certify that it appears, upon an examination of the within written certificate and the records of the corporation duly submitted to my inspection, that the requirements of sections four to nineteen, inclusive, of chapter one hundred and ten of the Revised Laws have been complied with, and I hereby approve said certificate, this fourteenth day of July A. D. nineteen hundred and two.

WILLIAM D. T. TREFRY,
Commissioner of Corporations.

Recorded Vol. 146, Page 625.

17

Received
Jul- 14, 1902.
Corporation Division.
Secretary's Office.

Commissioner of
Corporations.
Jul- 14, 1902.

C. THE COMMONWEALTH OF MASSACHUSETTS,
OFFICE OF THE SECRETARY,
BOSTON, April 4, 1918.

A true copy.

Witness the Great Seal of the Commonwealth.
[SEAL.]
ALBERT P. LANGLEY,
Secretary of the Commonwealth.

(Here follows diagram marked page 17.)

No. 421,
U. S.
Patent
$.10

19

183,942

219
15

SIMPLEX

Proprietor
American Steel Tank
By Richmond & Hughes
Attys

TRADE-MARK.

AMERICAN STEEL FOUNDRIES.
RAILWAY CAR COUPLINGS.
APPLICATION FILED SEPT. 9, 1907.

73,250. Registered Apr. 6, 1909.

SIMPLEX

Witnesses
Chas. F. Murray
Frederick P. Goodwin

Proprietor
American Steel Foundries
By Offield, Towle & Graves
Attorneys

No 421
A.S.F.
Newton
$18



Endorsed on cover: Commissioner of Patents. Patent Appeal Docket, No. 1218. In the Matter of the Application of American Steel Foundries. Court of Appeals, District of Columbia. Filed May 11, 1918. Henry W. Hodges, clerk.

19 United States Patent Office.

American Steel Foundries, of Jersey City, New Jersey, New York, N. Y., and Chicago, Illinois.

Trade-mark for Railway-car Couplings.

No. 73,250.

Statement and Declaration.

Registered April 6, 1909.

Application Filed September 9, 1907. Serial No. 29,837.

Statement.

To all whom it may concern:

Be it known that American Steel Foundries, a corporation duly organized and existing under and by virtue of the laws of the State of New Jersey, and having its principal office at Jersey City, in said State, with its principal offices and places of business outside of said State of New Jersey in the city of New York, State of New York, and city of Chicago, State of Illinois, has adopted for its use the trade-mark shown in the accompanying drawing, for railway-car couplers, in Class No. 19, Vehicles not including engines.

(Here follows diagram marked page 18.)

The trade-mark has been continuously used in the business of said corporation since June 1, 1907.

The trade-mark is displayed principally by the casting of the same into or upon such car couplers.

AMERICAN STEEL FOUNDRIES,
By WM. V. KELLEY, *Pres.*

Declaration.

STATE OF ILLINOIS,
County of Cook, ss:

William V. Kelley, being duly sworn, deposes and says that he is the president of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States of the United States; that the drawing presented truly represents the trade-mark sought to be registered; and that the specimens show the trade-mark as actually used upon the goods.

WM. V. KELLEY.

Subscribed and sworn to before me, a notary public, this 26th day of August, 1907.

[L. S.] FREDERICK C. GOODWIN,
Notary Public.

20

TRADE-MARK.

SIMPLEX RAILWAY APPLIANCE COMPANY.

RAILWAY CAR BOLSTERS.

APPLICATION FILED SEPT. 9, 1907.

81,752.

Registered May 2, 1911.

SIMPLEX

Witnesses.
E. Mann
E. N. Ford

Proprietor,
Simplex Railway Appliance Company
By Offield, Davis & Williams
Attys.

No. 4 v 17
U.S. Pt. Off.
Newton

21 United States Patent Office.

Simplex Railway Appliance Company, of Chicago, Illinois; Hammond, Indiana, and New York, N. Y.

Trade-mark for Railway-car Bolsters.

81,752.

Statement and Declaration.

Registered May 2, 1911.

Application Filed September 9, 1907. Serial No. 29,841.

Statement.

To all whom it may concern:

Be it known that Simplex Railway Appliance Company, a corporation duly organized under the laws of the State of Illinois, and having its main office in the city of Chicago, county of Cook, in said State, and with branch offices and places of business at Hammond, in the county of Lake and State of Indiana, and New York city, in the county and State of New York, has adopted for its use the trade-mark shown in the accompanying drawing, for railway-car bolsters, in Class 19, Vehicles, not including engines.

(Here follows diagram marked page 20.)

The trade-mark has been continuously used in the business of said corporation since August 1, 1897.

The trade-mark is displayed principally by the casting of the same into or upon such car bolsters.

SIMPLEX RAILWAY APPLIANCE COMPANY,
By WM. V. KELLEY, *Pres.*

Declaration.

STATE OF ILLINOIS,
County of Cook, ss:

William V. Kelley, being duly sworn, deposes and says that he is the president of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States of the United States, and between the United States and foreign nations or Indian tribes, and particularly with the Dominion of Canada; that the drawing presented truly represents the trade-mark sought to be registered; and that the specimens show the trade-mark as actually used upon the goods.

WM. V. KELLEY.

Subscribed and sworn to before me, a notary public, this 26th day of August, 1907.

[L. S.] FREDERICK C. GOODWIN,
Notary Public.

Copies of this trade-mark may be obtained for five cents each, by addressing the "Commissioner of Patents, Washington, D. C."

WEDNESDAY, March 12th, A. D. 1919.

* * * * * * *

No. 1218.

In the Matter of the Application of AMERICAN STEEL FOUNDRIES.

The argument in the above entitled cause was commenced by Mr. Geo. L. Wilkinson, attorney for the appellant, and was continued by Mr. T. A. Hostetler, attorney for the Commissioner of Patents, and was concluded by Mr. Geo. L. Wilkinson, attorney for the appellant.

In the Court of Appeals of the District of Columbia.

Patent Appeal, No. 1218.

In the Matter of the Application of AMERICAN STEEL FOUNDRIES.

Opinion per Curiam.

The Patent Office refused registration of the word "Simplex" as a trademark for brake riggings, on the ground that it was merely the name of a corporation, and several corporations are referred to in the opinion of the Office denying the registration- which have the word "Simplex" as the predominating word in their respective names. The refusal is in accord with our decisions. The Asbestone Co. v. The Carey Mfg. Co., 41 App. D. C. 507, In Re United Drug Co., 44 App. D. C. 209; Mansfield Tire & Rubber Co. v. Ford Motor Co., 44 App. D. C. 205; Burrell v. Simplex Electric Heating Co., 44 App. D. C. 452; Simplex Electric Heating Co. v. The Ramey Co., 46 App. D. C. 400.

For the reasons given by the Assistant Commissioner in his opinion, which appears in the record, where he reviews all the contentions of the applicant in the light of the adjudged cases, we affirm the decision of the Patent Office.

Affirmed.

MONDAY, May 5th, A. D. 1919.

* * * * * * *

April Term, 1919.

No. 1218.

In the Matter of the Application of AMERICAN STEEL FOUNDRIES.

Subject Matter: Trademark for Brake Rigging, etc. Serial No. 103,942.

Appeal from the Commissioner of Patents.

This cause came on to be heard on the transcript of the record from the Commissioner of Patents and was argued by counsel. On consid-

eration whereof, It is now here ordered and adjudged by this Court that the decision of the said Commissioner of Patents in this cause be and the same is hereby affirmed.

PER CURIAM.
May 5, 1919.

Court of Appeals of the District of Columbia.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 24 inclusive, constitute a true copy of the transcript of record and proceedings of said Court of Appeals, in the case of In the Matter of the Application of American Steel Foundries, No. 1218, Patent Appeal Docket, April Term, 1919, as the same remain upon the files and records of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this 26th day of May, A. D. 1919.

[Seal Court of Appeals, District of Columbia.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

26 UNITED STATES OF AMERICA, *ss:*

[Seal of the Supreme Court of the United States.]

The President of the United States of America to the Honorable the Judges of the Court of Appeals of the District of Columbia, Greeting:

Being informed that there is now pending before you a suit entitled In the matter of the application of American Steel Foundries, No. 1218, which suit was removed into the said Court of Appeals by virtue of an appeal from the Commissioner of Patents, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Court of Appeals and removed into the Supreme Court of the United States.

27 do hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Edward D. White, Chief Justice of the United States, the 16th day of October, in the year of our Lord one thousand nine hundred and nineteen.

JAMES D. MAHER,
Clerk of the Supreme Court of the United States.

28 [Endorsed:] File No. 27,176. Supreme Court of the United States, No. 421, October Term, 1919. American Steel Foundries vs. James T. Newton, Commissioner of Patents. Writ of Certiorari.

29 Court of Appeals of the District of Columbia.

No. 1218.

In the Matter of the Application of AMERICAN STEEL FOUNDRIES, Appellant.

Stipulation as to Return to Writ of Certiorari Granted October 13, 1919, and Issued October 16, 1919, by United States Supreme Court.

It is hereby stipulated and agreed that the certified transcript of record on file in the United States Supreme Court with the petition for a writ of certiorari may be taken as a return of the Court of Appeals of the District of Columbia to the said writ.

GEO. L. WILKINSON,
Counsel for American Steel Foundries.
T. A. HOSTETLER,
Counsel for James T. Newton, Commissioner of Patents.

Chicago, October 24, 1919.

Endorsed: No. 1218, Patent Appeal Docket. In the matter of the Application of American Steel Foundries. Stipulation as to Return to writ of certiorari. Court of Appeals, District of Columbia. Filed October 28, 1919. Henry W. Hodges, Clerk.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify, in obedience to the writ of certiorari hereto attached and returned herewith, the foregoing to be a true and correct copy of the stipulation of counsel filed in said cause the 28th day of October, A. D. 1919.

In testimony whereof, I hereunto subscribe my name and affix the seal of said Court, at the City of Washington, District of Columbia, this 28th day of October, A. D. 1919.

[Seal Court of Appeals, District of Columbia, 1893.]

HENRY W. HODGES,
Clerk,
By MONCURE BURKE,
Assistant Clerk.

[Endorsed:] File No. 27,176. Supreme Court U. S., October Term, 1919. Term No. 421. American Steel Foundries, Petitioner, vs. James T. Newton, Commissioner of Patents. Writ of Certiorari and Return. Filed Oct. 28, 1919.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1919.

No.

AMERICAN STEEL FOUNDRIES,

Petitioner,

vs.

JAMES T. NEWTON, Commissioner of Patents,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA, AND BRIEF IN SUPPORT THEREOF.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, American Steel Foundries, respectfully prays for a writ of certiorari to review the judgment of the Court of Appeals of the District of Columbia in the above-entitled cause.

Question Presented.

The sole question presented is the construction of Section 5 of the Trade-Mark Statutes. The construction given by the Court of Appeals of the District of Columbia precludes the Commissioner of Patents from registering a common-law trade-mark which forms part of the name of a corporation, even though the business of the corporation relates exclusively to merchandise in an entirely different and non-competing class from that on which the trade-mark is used. Petitioner uses the trade-mark "SIMPLEX" on railway car brakes; while the corporation, the Simplex Electric Heating Company, manufactures and sells electrically heated devices for household use.

Statements of the Facts.

(1) On May 19, 1917, petitioner, American Steel Foundries, filed an application in the United States Patent Office for the registration of the trade-mark "SIMPLEX" as applied to brake rigging, brake heads, brake beams, brake shoes, brake hangers, and clasp brakes, in Class 19, Vehicles Not Including Engines.

(2) On July 19, 1917, the Examiner of Trade-Marks in the United States Patent Office refused registration of petitioner's trade-mark in view of the ruling in *ex parte* Simplex Electric Heating Company, 123 MS. D., 114. The ruling referred to had been made by the Commissioner of Patents in granting a petition of Simplex Electric Heating Company, and was to the effect that the Examiner of Trade-Marks be instructed to reject any application for registration of "SIMPLEX" as a trade-mark. The ruling of the Commissioner was pursuant to a decision of the Court of Appeals of the Dis-

trict of Columbia in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400.

(3) On October 27, 1917, petitioner, American Steel Foundries, filed a request for reconsideration of the refusal of the Examiner of Trade-Marks to register its trade-mark, and, in support thereof, presented the argument that the merchandise to which petitioner had applied its trade-mark "SIMPLEX" was not of the same class, or of the same descriptive properties as any merchandise manufacured or sold by the Simplex Electric Heating Company.

(4) On November 2, 1917, the Examiner of Trade-Marks again refused registration of petitioner's trade-mark "on the grounds stated in the first Office letter of July 19, 1917; the decision therein cited is controlling on the Examiner."

(5) On November 21, 1917, petitioner appealed to the Commissioner of Patents in person from the refusal of the Examiner of Trade-Marks to register its trade-mark, which appeal was duly perfected and orally argued before the then Assistant Commissioner of Patents.

(6) On February 23, 1918, the then Assistant Commissioner of Patents rendered a decision affirming the refusal of the Examiner of Trade-Marks to register petitioner's said trade-mark, and in his opinion stated:

> "I am inclined to agree with this applicant's contention that the 'mere name' referred to in the statute means a name to which the corporation has some claim as to its own property; but as I understand it the Court has held that this is the case with 'Simplex,' the name of the Simplex Electric Heating Company. Therefore, on the Court's construction of the wording of the statute, the applicant's mark must be refused registration. The Examiner's ruling is sustained."

(7) On March 29, 1918, petitioner notified the Com-

missioner of Patents of its appeal to the Court of Appeals of the District of Columbia, which appeal was duly perfected and orally argued before said court.

(8) On May 5, 1919, a decision was rendered by the Court of Appeals of the District of Columbia affirming the refusal of the Assistant Commissioner of Patents to register petitioner's trade-mark.

Statute Involved.

Section 5 of the Act of February 20, 1905, authorizing the registration of trade-marks, is in part as follows:

> "That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> . . . . . .
>
> "*Provided,* That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, . . . shall be registered under the terms of this Act."

The Court of Appeals of the District of Columbia has so construed the above proviso clause as to preclude the registration of a trade-mark, which distinguishes the goods of the owner of the mark from other goods of the same class, when such trade-mark forms part of the name of a corporation engaged in the manufacture and sale of an entirely different class of goods.

Reasons of Public Import for the Issue of the Writ.

This construction of the statute deprives hundreds of American manufacturers of the advantages of registering their common-law trade-marks. In many foreign countries, particularly in South America, a trade-

mark of a foreigner can only be registered after registration in the home country, and, hence, American manufacturers whose trade-marks are refused registration in this country under the present construction of the statute cannot register their marks in foreign countries, which results in unscrupulous persons registering American trade-marks in such foreign countries and preventing the American trade-marked goods from being imported into such countries unless exorbitant sums are paid to the piratical registrants.

The construction of the statute in question is, therefore, a matter of great importance to American manufacturers, especially at this time when they are making unusual effort to extend their foreign trade.

The construction which the Court of Appeals of the District of Columbia has placed upon the statute in question is inconsistent with the long recognized purpose and intent of the trade-mark law, and denies the benefits and advantages, which the trade-mark law was intended to confer, to numerous owners of common-law trade-marks.

For the above reasons it is submitted that a writ of certiorari should issue, and the question involved be determined by this court.

AMERICAN STEEL FOUNDRIES.
By GEORGE L. WILKINSON,
Counsel for Petitioner.

I hereby certify that I have examined and read the foregoing petition for writ of certiorari, and that, in my opinion, said petition is well founded and should be granted by this Honorable Court.

GEORGE L. WILKINSON,
Counsel for Petitioner.

June 20, 1919.

BRIEF.

The sole ground of refusing registration is that petitioner's trade-mark "Simplex" consists merely in the name of a corporation—namely, the Simplex Electric Heating Company.

There is no contention that petitioner's trade-mark is anticipated, or that the said trade-mark is not the common-law property of petitioner as applied to the class of merchandise to which it has applied it. The Examiner of Trade-Marks in his action of July 19, 1917 (R. 5) stated:

> "The search in Class 19 fails to show that the mark is anticipated."

Petitioner in its amended statement (R. 10) alleges a continued use of the trade-mark Simplex in its business, and in the business of its predecessors, since on or about August 1, 1897. This statement is supported by petitioner's prior registration of the same trade-mark, No. 73,250, April 6, 1909, for railway car couplers in Class 19, Vehicles, which has been continuously used since June 1, 1907 (R. 19), and by the prior registration of the same trade-mark by petitioner's predecessors, Simplex Railway Appliance Co., for railway car bolsters in Class 19, Vehicles, which has been continuously used since August 1, 1897 (R. 21).

There is no contention that the Simplex Electric Heating Company, or any other company, has appropriated the trade-mark "Simplex" for merchandise of the same descriptive properties as the merchandise for which the trade-mark has been appropriated by petitioner.

There is no contention that petitioner has not acquired a good and valid common-law right to the said trade-mark as applied to merchandise in Class 19, Vehicles.

The sole question presented for consideration is,

therefore, whether the phrase "That no mark which consists merely of the name of an individual, firm, corporation, or association . . . shall be registered under the terms of this Act," occurring in Section 5 of the Act of February 20, 1905, precludes the Commissioner of Patents from registering a trade-mark which conforms to all of the requirements and possesses all of the characteristics necessary to a valid common-law trade-mark.

For the convenience of the court we here quote in full Section 5 of the Trade-Mark Act:

> "That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> "(*a*) Consists of or comprises immoral or scandalous matter.
>
> "(*b*) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided,* That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive

purchasers shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further*, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof."

Points of Law to Be Discussed.

1. Purpose and intent of the trade-mark law.

2. Common-law right of appellant to "Simplex" as a trade-mark for vehicles.

3. Simplex Electric Heating Company has no exclusive right to "Simplex" as a trade-mark on any goods other than those to which it has appropriated it.

4. Simplex Electric Heating Company by virtue of its name has no exclusive right to the word "Simplex," but is merely entitled to protection from fraudulent or deceptive use of its name by others.

5. Section 5 of the Trade-Mark Act cannot, under

the following well-established rules for interpreting statutes, be so construed as to bar petitioner's registration:

(*a*) "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them." *Caminetti* v. *United States*, 242 U. S., 470, 485.

(*b*) "Where a particular construction of a statute will occasion great inconvenience or produce inequality or injustice, that view is to be avoided if another and more reasonable interpretation is present in the statute." *Knowlton* v. *Moore*, 178 U. S., 77.

(*c*) "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation." *Caminetti* v. *United States, supra.*

(*d*) "It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers." *Holy Trinity Church* v. *United States*, 143 U. S., 457, 459.

(*e*) "The enacting clause is, of course, the principal part of the statute, and, as its terms may be presumed to have embodied the main object of the act, the proviso should be strictly construed." 36 Cyc., 1161.

6. Previous interpretations of the statute in question.
7. *Stare decisis.*

Purpose and Intent of the Trade-Mark Law.

This court in *Elgin National Watch Co.* v. *Illinois Watch Co.*, 179 U. S., 665, 673, in defining the term "trade-mark," said:

"The term has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers of the vendible commod-

> ities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."

The object and purpose of the trade-mark law are to confer upon the owner of a valid common-law trade-mark a statutory right to such trade-mark, together with certain advantages which flow therefrom and which are not derived from the common-law right. A registration under the trade-mark statute is *prima facie* evidence of ownership; it permits the owner to protect his rights in the Federal Courts regardless of diverse citizenship and the amount involved; it renders it unnecessary for him to prove a fraudulent knowledge and intent on the part of an infringer of his trade-mark; and it enables him to obtain registration of his mark in foreign countries.

This court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S., 461, 465, construing the section of the trade-mark law here in question—namely, Section 5—said:

> "The owner of a trade-mark valid at common law and used in commerce with foreign nations, or among the several States, or with Indian tribes, may obtain its registration under the Act without showing the user of ten years required by this clause."

The clause referred to is that which permits registration of trade-marks, otherwise unregistrable, which have been in actual and exclusive use by the applicant for ten years previous to the passage of the Act.

Mr. Justice Miller, speaking for this court in the Trade-Mark Cases, 100 U. S., 82, 92, described the trade-mark laws then in force as follows:

> "It is sufficient at present to say that they provide for the registration in the Patent Office of any device in the nature of a trade-mark to which any person has by usage established an exclusive right, or which the person so registering intends to appropriate by that act to his exclusive use; and they make the wrongful use of a trade-mark, so registered, by any other person, without the owner's permission, a cause of action in a civil suit for damages."

Not only has it been the purpose and intent of previous Trade-Mark Acts to extend statutory protection through registration to one who has acquired a common-law right to a trade-mark, but the Committee on Patents of the House of Representatives, in their report recommending the passage of the present act, said, in reference to the particular section here in question, as follows:

> "In the past there has been considerable complaint in regard to what could be registered under the existing law as a trade-mark. Much of the time of the committee in the hearing of the bill has been consumed in a discussion upon this particular feature of the legislation. *Sec. 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark.*" (Italics ours.)

It, therefore, being well established that it is the purpose and intent of the trade-mark law to register trade-marks to which the applicant has acquired a common-law right, it becomes pertinent to consider, first, whether petitioner has acquired a common-law right to the trade-mark "Simplex" as applied to merchandise in the general class of vehicles; and, second, whether the wording of the present trade-mark law must be so

construed as to prevent Section 5 of the Act of 1905 from accomplishing the recognized purpose and intent of the trade-mark law.

Common-Law Right of Petitioner to "Simplex" as a Trade-Mark for Vehicles.

The trade-mark "Simplex" was originally adopted and used by petitioner's predecessor, Simplex Railway Appliance Company, for railway car bolsters, in Class 19, Vehicles, on August 1, 1897. Petitioner since June 1, 1907, has continuously used the said trade-mark on railway car couplers, in Class 19, Vehicles, and has since April 16, 1917, continuously used the said trade-mark in railway brakes in the same Class 19, Vehicles.

In order to defeat petitioner's common-law right to the said trade-mark as applied to merchandise in Class 19, Vehicles, it is necessary that it should appear that some other corporation, firm or individual had previously adopted it and has continuously used it on the same class of merchandise, or on "merchandise of the same descriptive properties." The fact that the said trade-mark may have been previously adopted and used by others on merchandise of other descriptive properties in no way militates against petitioner's common-law right to said trade-mark as applied to vehicles and to all merchandise included in such general class. The use by different parties of the same trade-mark on merchandise of the *same* descriptive properties is "likely to cause confusion or mistake in the mind of the public or to deceive purchasers," and hence is properly prohibited both by statute and by common law.

Although the trade-mark "Simplex" has been adopted and used by some sixty parties, as indicated by the registrations appearing in the record of D. C. Court

of Appeals in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400, there is no contention that the appropriation of the said trade-mark by petitioner to merchandise in the classes of vehicles is likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. Under the above state of facts petitioner has acquired a valid common-law right to the said trade-mark. This court, in *Canal Co.* v. *Clark*, 80 U. S., 311, 322, in considering the question of common-law trade-marks, said:

> "Undoubtedly words or devices may be adopted as trade-marks which are not original inventions of him who adopts them, and courts of equity will protect him against any fraudulent appropriation or imitation of them by others. Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions. Words in common use, with some exceptions, may be adopted, *if, at the time of their adoption, they were not employed to designate the same, or like articles of production.* The office of a trade-mark is to point out distinctively the origin, or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer." (Italics ours.)

Petitioner's common-law right to the trade-mark "Simplex" as applied to merchandise in the class of vehicles is within all of the authorities, and is not contested by the Patent Office.

Simplex Electric Heating Company Has No Exclusive Right to "Simplex" as a Trade-Mark on Any Goods Other Than Those to Which It Has Appropriated It.

The fact that the Simplex Electric Heating Company has adopted and used the trade-mark "Simplex" is no bar to the recognition of petitioner's right thereto when applied to merchandise in the class of vehicles. The

Simplex Electric Heating Company has never adopted and used the said trade-mark on merchandise in the class of vehicles, or in any class of merchandise of the same descriptive properties. The Simplex Electric Heating Company was not incorporated until 1902, five years subsequent to the adoption and use of the trade-mark "Simplex" by petitioner's predecessor. The Simplex Electric Heating Company was organized to take over that part of the business of the Simplex Electrical Company which resided in the manufacture and sale of electrically heated devices. It does not appear that said company has ever used the trade-mark "Simplex" on any other class of merchandise. From 1898 until 1902 the Simplex Electrical Company had manufactured and sold electrically heated devices, and prior thereto such devices had been manufactured and sold by the American Electric Heating Company, which in 1896 had accumulated some two or three hundred patents relating to electric heating devices. These facts appear in the opinion of the Court of Appeals of the District of Columbia in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400, but it does not appear from the opinion of the court in said case that the Simplex Electric Heating Company used the trade-mark "Simplex," or that the said trade-mark was used by any predecessor of the Simplex Electric Heating Company prior to 1898. Whether or not the trade-mark "Simplex" had been used by the predecessor of the Simplex Electric Heating Company prior to August 1, 1897, when it was adopted and used by appellant's predecessor, is wholly immaterial, as any use of such trade-mark by the Simplex Electric Heating Company, or its predecessors, was on merchandise of different descriptive properties from vehicles. The Simplex Electric Heating Company, therefore, has never acquired any right to the trade-

mark "Simplex" as applied to vehicles, or any parts thereof. The said company's right to the trade-mark "Simplex" is limited to merchandise of the same descriptive properties as that on which it has used the said trade-mark, and it has no right to said trade-mark as applied to merchandise of any other descriptive properties.

This court, in *Canal Co.* v. *Clark, supra,* said (p. 323):

> "No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself."

This court in *Columbia Mill Co.* v. *Alcorn,* 150 U. S., 460, 463, stated as one of the essential requisites to a valid trade-mark the following:

> "That the exclusive right to the use of the mark or device claimed as a trade mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles of production."

This court again defined the scope of a trade-mark in *Standard Paint Co.* v. *Trinidad Asphalt Co.,* 220 U. S., 446, 454, as follows:

> "A trade mark, it was hence concluded, 'must therefore be distinctive in its original signification, point to the origin of the article, or it must have become such by association.' But two qualifying rules were expressed, as follows: 'No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed.' "

This court in *Hanover Star Milling Co.* v. *Metcalf,* 240 U. S., 403, 414, quoted with approval the following

excellent summary of the law of trade-marks from the opinion of Vice Chancellor Sir Wm. Page Wood, in *Ainsworth* v. *Walmsley*, L. R., 1 Eq., 518, 524:

> "'This court has taken upon itself to protect a man in the use of a certain trade-mark as applied to a particular description of article. *He has no property in that mark per se, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade.* If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them, the court has said that no one shall be at liberty to defraud that man by using that mark, and passing off goods of his manufacture as being the goods of the owner of that mark.'" (Italics ours.)

To the same effect is the recent decision of this court in *United Drug Co.* v. *Theodore Rectanus Co.*, 39 Sup. Ct., 48:

> "There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed. The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property except in connection with an existing business. *Hanover Milling Co.* v. *Metcalf*, 240 U. S. 403, 412-414, 36 Sup. Ct. 357, 60 L. Ed. 713."

This court, in *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S., 403, 415, held that the first adopter of the trade-mark "Tea Rose" as applied to flour was limited in its exclusive right to said mark to the territory in

which it had sold the flour, and that it could not enforce its trade-mark against one who had later adopted and used the same trade-mark on flour in other territory. This court said:

> "Into whatever markets the use of a trade mark has extended, or its meaning has become known, there will the manufacturer or trader whose trade is pirated by an infringing use be entitled to protection and redress. But this is not to say that the proprietor of a trade-mark, good in the markets where it has been employed, can monopolize markets that his trade has never reached, and where the mark signifies not his goods, but those of another."

The same rule announced by this court as to territory applies to classes of goods, and one who has adopted and used a trade-mark on one class of goods can no more enforce the said trade-mark against one who has later adopted it and used it on another class of goods, than can the originator of the trade-mark enforce it in territory in which he has not used it.

The Simplex Electric Heating Company, therefore, has, under well-established law, no right to the trade-mark "Simplex" as applied to any other goods than those to which it has appropriated it. It has never adopted and used the said trade-mark on vehicles, or parts thereof, and hence has no right which would be injured by the registration of the said trade-mark by petitioner. Furthermore, it has no right under its charter (R. 15) to engage in the manufacture or sale of vehicles or brakes for railway cars.

Simplex Electric Heating Company by Virtue of Its Name Has No Exclusive Right to the Word "Simplex."

It was evidently the intention of the portion of Section 5 of the Trade-Mark Act under consideration—namely, "no mark which consists merely in the name of an individual, firm, corporation, or association . . . shall be registered"—to recognize the common-law right of a corporation to protection against fraudulent use of its name by others.

The general rule governing the supervision of equity over the names of corporations was well stated in *Higgins Co.* v. *Higgins Soap Co.*, 144 N. Y., 462, as follows:

> "In respect to corporate names, an injunction lies to restrain the simulation and use by one corporation of the name of a prior corporation which tends to create confusion, and to enable the later corporation to obtain, by reason of the similarity of names, the business of the prior one. The courts interfere in these cases, not on the ground that the state may affix such corporate names as it may elect to the entities it creates, but to prevent fraud, actual or constructive."

The law was also well stated by Judge Bradley, in *Celluloid Mfg. Co.* v. *Cellonite Mfg. Co.*, 32 F. R., 94, 97, as follows:

> "Fair competition in business is legitimate, and promotes the public good; but an unfair appropriation of another's business, by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or any other way, is justly punishable by damages, and will be enjoined by a court of equity."

The right of a corporation to its name extends no further, and does not give to a corporation the exclusive right to a word which it may have adopted as part of

its name. If it has used such word as a trade-mark applied to certain merchandise, it is protected in the use of such word, not because it is part of its name, but because it has a common-law right to it as a trade-mark. A generic word embodied in a corporate name is not entitled to protection in equity. The same principle which protects a corporation in the use of its own name operates to prevent the corporation from interfering with the use by others of that part of its name which was previously known to and used by others, and to which it has no more right than they have.

The Court of Appeals for the Seventh Circuit, in *Keystone Oil & Mfg. Co.* v. *Buzby*, 219 Fed. Rep., 473, 476, in holding that the plaintiff did not acquire exclusive right to the word "Keystone" as a trade-mark merely because it formed part of its corporate name, said:

> "The contention on behalf of the appellee for support of the decree, as we understand it, is this in effect: That the word 'Keystone' has been so appropriated by the appellee in his business that his rights have become exclusive for its use in the marking and sale of lubricants. Such broad view, however, is untenable under the entire current of authorities. Words which are common to the public cannot be thus appropriated for exclusive use, beyond the limited extent recognized for the protection either of trade-marks against infringers or of trade-names against deceptive imitators. In the leading trade-mark case of *McLean* v. *Fleming*, 96 U. S. 245, 252, 24 L. Ed. 828, speaking in reference to trade-mark rights of a person in his own name, the opinion states the rule that:
>
> "'Such a party is not, in general entitled to the exclusive use of a name merely as such, without more. . . . Instead of that, he cannot have such a right, even in his own name, as against another person of the same name, unless such other person uses a form of stamp or label so like that used by the complaining party as to rep-

> resent that the goods of the former are of the latter's manufacture.'
>
> ". . . No person can acquire exclusive rights to employ any name or word, as part of his trade-name; but one may acquire reputation for his business or goods under any designation he has adopted therefor, and other traders are excluded under the rule from filching his trade by deceptive use of like designation."

The word "Simplex" is an ordinary English word directly adopted from the Latin. It appears in Ogilvie's Imperial Dictionary, published in London in 1882; in Cassel's Encyclopedic Dictionary, published in New York, New York, in 1887; and in the Standard Dictionary, published in 1895. It is, therefore, a word which was well known long prior to any alleged adoption of it as a part of the corporate name of the Simplex Electric Heating Company.

It appears from the records of the Court of Appeals of the District of Columbia in *Simplex Electric Heating Company* v. *Ramey Co., supra*, that the word "Simplex" has been registered at least sixty times, as applied to various classes of merchandise. Registration No. 56,842, October 23, 1906, Jas. Chadwick & Bro., shows that a trade-mark comprising the word "Simplex" has been in use on sewing thread since 1859. On October 28, 1890, "Simplex" was registered as a trade-mark for insulated wire by a firm called the Simplex Electrical Company, registration No. 18,552.

It also appears in the said records that more than sixty corporations listed in the directories of a number of the largest cities in this country have names of which the word "Simplex" forms a part. The Simplex Gas Machine Co., of New York, was incorporated October 16, 1884; the Simplex Mfg. Co., of New York, on October 14, 1890; the Simplex Dairy Co., of West Virginia,

February 5, 1896; and the Simplex Railway Appliance Co. of Illinois, petitioner's predecessor, on July 30, 1897.

The Simplex Electric Heating Company, therefore, was not the first to use the word "Simplex" as part of a corporate name, nor was it the first to use the word "Simplex" as a trade-mark.

The word "Simplex" is not only not *merely* the name of a corporation, the Simplex Electric Heating Company, but it is not the distinguishing name of said corporation. The name "Simplex" is just as distinctive of the various other sixty or more corporations in the names of which it appears, and many of which were incorporated before the Simplex Electric Heating Company, as it is of the latter corporation. The word "Simplex" does not identify any corporation in particular, because it is equally the name of various corporations. If the "Simplex Company" were referred to without any other identifying words it would not be known to what corporation reference was made.

The Simplex Electric Heating Company merely adopted as part of its name a word already in common use in names and trade-marks.

The word "Simplex" no more identifies the name of the Simplex Electric Heating Company than do the words "Electric" or "Heating." In fact, in order to distinguish the name of the said company from the Simplex Electric Company, it was necessary that the word "Heating" should be added. This name, if any, is therefore the essential distinguishing feature in the name of the said company.

The Simplex Electric Heating Company acquired no common-law right generally to the word "Simplex" through its adoption of such word as part of its name, and it could not in a court of equity enjoin the use of

such name by others unless intentionally used to deceive the public and to injure the said company. The phrase in Section 5 of the Trade-Mark Act under discussion was clearly only intended to recognize the common-law right of a corporation to its name and its equitable right to be protected from the fraudulent use of its name.

Section 5 of the Trade-Mark Act Cannot, Under the Following Well-Established Rules for Interpreting Statutes, Be So Construed as to Bar Petitioner's Registration.

The phrase in Section 5 of the Trade-Mark Act under discussion, namely,

> "no mark which consists merely in the name of an individual, firm, corporation, or association . . . shall be registered under the terms of this Act,"

when interpreted by any and all of the recognized rules for the interpretation of statutes constitutes no bar to the registration by petitioner of the trade-mark "Simplex" as applied to the goods to which it has appropriated it, as it distinguishes such goods "from other goods of the same class."

The first rule as to the interpretation of statutes is well stated by this court in *Caminetti* v. *United States*, *supra*, as follows:

> "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them."

The trade-mark sought to be registered, "Simplex," is one of the three words of the name of the Simplex Electric Heating Company. Is the one word "Simplex" "*merely*" the name of the Simplex Electric Heating Company? To so hold would be to utterly disregard

the ordinary and usual meaning of the word "merely."

The Century Dictionary defines the word "merely" as follows:

> "1. Absolutely; wholly; completely; utterly.
> "2. Simply; solely; only."

Thus the word "merely" in the context under discussion must mean one of two things—namely, that the trade-mark sought to be registered must be something other than the sole verbal feature of a party's name; or that the word must be more than a name in the sense that its inherent character is such that it may become a trade-mark; that is to say, it is sufficiently arbitrary or fanciful in its application to entitle the user to sequester it in the particular line of manufacture in which he is engaged.

That the word "Simplex" is arbitrary and fanciful, and not "merely" a name in the sense of this interpretation of the expression, is conclusively shown by the fact that it has been recognized and registered as an arbitrary, fanciful name or trade-mark in the numerous instances cited in the record in *Simplex Electric Heating Co.* v. *Ramey Co., supra.*

That the word "Simplex" (taking the other interpretation of the expression) does not constitute absolutely, or wholly, or completely, or utterly, or simply, or solely, or only, the name of the Simplex Electric Heating Company is too obvious to need argument. In order to refuse registration of petitioner's trade-mark "Simplex" it is necessary to amend the phrase of Section 5 of the Trade-Mark Act under consideration by eliminating the word "merely" and by inserting after the word "consists" the phrase "of part of," so that the said phrase will read:

> "No mark which consists *of part* of the name of an individual, firm, corporation, or association

. . . shall be registered under the terms of this Act."

The recognized rules of statute interpretation do not permit the language in which the statute is stated to be so judicially amended.

It is submitted, in fact, that when the Simplex Electric Heating Company registered its trade-mark "Simplex Quality" on September 11, 1906, Section 5 of the Trade-Mark Act had not been amended by adding thereto the last proviso, namely:

> "That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof."

The law, therefore, at that time precluded the registration as a trade-mark *merely* the name of a corporation, whether said corporation was the applicant or not. In registering the said trade-mark, in which the only registrable word is "Simplex," the Patent Office necessarily ruled that the mark "Simplex" was not merely the name of the Simplex Electric Heating Company. The ruling of the Patent Office in registering the said trade-mark, and thereby holding that the word "Simplex" was not merely the name of the Simplex Electric Heating Company, undoubtedly properly construed the trade-mark law, and should have followed its precedent by registering petitioner's trade-mark.

Under the elemental rule of statute interpretation petitioner is entitled to register its trade-mark "Simplex," as it is not "merely the name" of the corporation, Simplex Electric Heating Company, or of any other corporation.

Another recognized rule which controls the construction of statutes is that where a particular construction will cause injustice, a more reasonable interpretation

must be given. This principle was reiterated by this court in *Knowlton* v. *Moore,* 178 U. S., 41, 77, as follows:

> "We are, therefore, bound to give heed to the rule, that where a particular construction of a statute will occasion great inconvenience or produce inequality and injustice, that view is to be avoided if another and more reasonable interpretation is present in the statute. *Bate Refrigerating Co.* v. *Sulzberger,* 157 U. S. 1, 37; *Wilson* v. *Rousseau,* 4 How. 646, 680; *Bloomer* v. *McQuewan,* 14 How. 539, 553; *Blake* v. *National Banks,* 23 Wall. 307, 320; *United States* v. *Kirby,* 7 Wall. 482, 486."

If Section 5 of the Trade-Mark Law is construed as has been done by the Court of Appeals of the District of Columbia, injustice will be done petitioner. Petitioner unquestionably has a common-law right to the trade-mark "Simplex" as applied to the various parts of railroad vehicles to which it has continuously applied it since August 1, 1897. It, therefore, has also acquired a statutory right to such trade-mark and to the benefits which are derived from registration of its trade-mark.

If registration is refused petitioner will be precluded from enforcing its right to its said trade-mark in the Federal courts, unless the statutory amount and diversity of parties are present. The refusal to register its trade-mark deprives it of the *prima facie* right thereto incident to registration and renders it necessary to prove a fraudulent intent on the part of an infringer.

Furthermore, the refusal to register petitioner's trade-mark renders it impossible to register it in many foreign countries, and hence leaves it a prey to scheming parties in foreign countries to register petitioner's trade-mark and prevent petitioner from shipping its merchandise bearing thereon its trade-mark into such foreign countries unless such piratical registrants are paid whatever sums they may demand.

The interpretation which the Court of Appeals of the District of Columbia has placed upon the section of the Trade-Mark Law in question, therefore, instead of benefiting American owners of trade-marks, benefits those scheming individuals who make it a practice to register American trade-marks in foreign countries, and prevent importation into such countries of the goods of the American legal owners of the trade-marks.

The interpretation of the statute in question contended for, while necessary in order to avoid injustice to petitioner, will in nowise work an injustice to the Simplex Electrical Heating Company, or any other person or concern. The said company is not entitled by common law to the trade-mark "Simplex" as applied to brake rigging, brake heads, brake beams, brake shoes, brake hangers, or clasp brakes, as it has never used the said trade-mark on such merchandise, nor can it in the future use the said trade-mark on such merchandise in view of the prior appropriation by petitioner. The registration of petitioner's trade-mark will in no wise result in any confusion of its goods with those of the Simplex Electric Heating Company, nor result in any possible infringement of the right of said company to the use of its corporate name.

Should there be a doubt as to the proper interpretation of the phrase in question of Section 5 of the Trade-Mark Law, that interpretation should be given which will be consistent with the intent and purpose of the law. In determining the intent and purpose of a law it was stated by this court in *Caminetti* v. *United States, supra:*

> "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation, *Blake* v. *National Banks,* 23 Wall. 307, 319; *Bate Refrigerating Co.*

v. *Sulzberger,* 157 U. S. 1, 42; *Chesapeake and Potomac Telephone Co.* v. *Manning,* 186 U. S. 238, 246; *Binns* v. *United States,* 194 U. S. 486, 495."

The report of the Committee on Patents of the House of Representatives, in recommending the passage of the present Trade-Mark Act, is pertinent, therefore, in determining whether Section 5 should be interpreted as contended for by appellant, or as has been done by the Commissioner of Patents. The following quotation is for convenience here repeated from the report of the said committee:

> "In the past there has been considerable complaint in regard to what could be registered under the existing law as a trade-mark. Much of the time of the committee in the hearing of the bill has been consumed in a discussion upon this particular feature of the legislation. Sec. 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark."

It, therefore, was the purpose and intent of Section 5 of the Trade-Mark Act that it should permit

> *"registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark."*

The interpretation which has been given to Section 5 by the Court of Appeals of the District of Columbia prevents the registration to petitioner of its trade-mark "Simplex," although it clearly has established its common-law right to such trade-mark and has acquired a property right therein as applied to the merchandise to which it has appropriated it.

While it is contended on behalf of petitioner that the

word "merely" cannot under any logical interpretation be held to mean that the word "Simplex" is merely Simplex Electric Heating Company, yet if there is any doubt it should be resolved in favor of appellant's contention in view of the purpose and intent of the Trade-Mark Law, and particularly Section 5, as stated in the report of the Committee on Patents of the House of Representatives in recommending the passage of the Trade-Mark Act.

Even if the words of Section 5 of the Trade-Mark Act in question were only susceptible of the literal meaning attributed to them by the Court of Appeals of the District of Columbia, nevertheless appellant would be entitled to the registration of its trade-mark on the well-established ground that the words of a statute will be disregarded when they are in conflict with the spirit and intent of the law.

Justice Brewer, in rendering the opinion of this court in *Holy Trinity Church* v. *United States*, 143 U. S., 457, 459, forcefully stated this rule as to the interpretation of the statutes as follows:

> "It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers. This has been often asserted, and the reports are full of cases illustrating its application. This is not the substitution of the will of the judge for that of the legislator, for frequently words of general meaning are used in a statute, words broad enough to include an act in in question, and yet a consideration of the whole legislation, or of the circumstances surrounding its enactment, or of the absurd results which follow from giving such broad meaning to the words, makes it unreasonable to believe that the legislator intended to include the particular act. . . . It is a case where there was presented a definite evil, in view of which the legislature used general

terms with the purpose of reaching all phases of that evil, and thereafter, unexpectedly, it is developed that the general language thus employed is broad enough to reach cases and acts which the whole history and life of the country affirm could not have been intentionally legislated against. It is the duty of the courts, under those circumstances, to say that, however broad the language of the statute may be, the act, although within the letter, is not within the intention of the legislature, and therefore cannot be within the statute."

This court, in its recent decision in *Rock Springs Distilling Co. et al.* v. *Gaines Co.*, 38 Sup. Ct. Rep., 327, quoted with approval the following statement of Judge Sanborn, in *Layton Pure Food Co.* v. *Church & Dwight Co.*, 182 F. R., 35:

> " 'Uniformity and certainty in rules of property are often more important and desirable than technical correctness.' "

Under the uniform and well-recognized rule of property in trade-marks petitioner is entitled to the exclusive right to the trade-mark "Simplex" when applied to merchandise for which it was first to appropriate it. The recognition of this property right of petitioner, through the registration of its trade-mark, is more important and desirable than any technical correctness in the construction of the words "merely in the name of an individual, firm, corporation, or association."

The enacting clause of Section 5 of the Trade-Mark Act is:

> "No mark by which the goods of the owner of the mark may be distinguished from other goods of *the same class, shall be refused* registration as a trade-mark on account of the nature of such mark, unless such mark consists," etc.

The first exception or proviso embraces marks which

as a matter of policy are of such universal import and significance as to render them immune to appropriation for trade-mark purposes by anyone. These marks include emblems and insignia of states, nations and organizations of a social or fraternal nature which are to be deemed of a *higher order* in their relation to the political and social body than mere trading organizations. Obviously classification of goods are not involved in this prohibition, since questions of public policy rather than trade rights are the determining factor.

The second exception or proviso embraces marks which have already been appropriated for trade purposes and applied to goods "of the *same* descriptive properties." Priority of adoption in the *same class* of goods is the basis for this prohibition.

The third exception or proviso is the one with which we are most intimately concerned. This is an exception or proviso which is *in reduction* of the right to register specified in the main enacting clause, and must be thus construed *in relation thereto.* The main enacting clause is directed to distinguishing marks in *the same class,* and to that class only is the *exception* applicable. In the absence of this and other exceptions *all* marks which serve to distinguish the owner's goods "from other goods *of the same class*" would be entitled to registration, and mandamus proceedings would lie against the Commissioner for refusing to register.

The exception must thus be strictly construed, since it is in mitigation of a statutory right which would be otherwise enforceable. This reasoning is further emphasized by an analysis of the third exception itself.

That exception provides, among other things, that no mark "which consists . . . merely in words or devices which are *descriptive of the goods with which they are used* or of the character or quality of such goods . . . shall be registered." It is obvious that this ex-

ception is not a wholesale prohibition against the use of words which in association with *other* kinds of goods may be considered *descriptive,* but that the prohibition is directed to words which are descriptive of the *particular* goods to which they are applied.

The above suggestions apply to almost any adjective. An adjective is intrinsically a qualifying or *descriptive* word, and yet a multitude of such words have been registered, and are always considered registrable if not descriptive of the *particular class* to which they are applied.

The fact that the third exception or proviso contains within itself a class limitation with respect to the registrability of descriptive words merely emphasizes the fact that eveything specified within the third exception must be interpreted and construed as in reduction of rights *elsewhere conferred.* This is the only interpretation of this paragraph which is in harmony with the general tenor of the Trade-Mark Act and which will further the purpose of the legislature "to give a wide latitude to registry."

The main enacting clause having been framed with reference to the classification of goods, it necessarily follows that like considerations permeate every proviso to which they are *applicable,* especially when the statute is thus brought into harmony with the entire theory of trade rights long announced by the courts both in this country and Great Britain.

Furthermore, it is the only interpretation which is in harmony with the rules regarding the interpretation of statutes, which rules always recognize the fact that provisos and exceptions must be limited in their application to the particular subject-matter carved out or exempted from the operation of the main enacting clause.

The relation of a proviso to its context is thus set forth in 36 Cyc., 1161, as follows (italics ours):

> "A proviso is a clause engrafted on a preceding enactment for the purpose of restraining or modifying the enacting clause, or of excepting something from its operation which otherwise would have been within it, or of excluding some possible ground of misinterpretation of it, as by extending it to cases not intended by the legislature to be brought within its purview. The proviso is generally introduced by the word 'provided,' but its existence and effect are to be determined rather by its matter and substance than by its form. *It should be construed together with the enacting clause, with a view to giving effect to each and to carrying out the intention of the legislature as manifested in the entire act.* The enacting clause is, of course, the principal part of the statute, and, as its terms may be presumed to have embodied the main object of the act, the proviso should be strictly construed. The appropriate office of the proviso is to restrain or modify the enacting clause; and *not to enlarge it.*"

As further explaining the manner in which the statute should be construed, we find in 36 Cyc., 1128, the following statement:

> "It is a cardinal rule in the construction of statutes that effect is to be given, if possible, to every word, clause, and sentence. It is the duty of the court, so far as practicable, to reconcile the different provisions, so as to make them consistent and harmonious, and to give a sensible and intelligent effect to each."

And again, in 36 Cyc., 1131, the following (italics ours):

> "The words, phrases, and sentences of a statute are to be understood as used, not in any abstract sense, but *with due regard to the context,* and in that sense which best harmonizes with all other parts of the statute. In expounding one part of a statute therefore *resort should be had to every*

> *other part*, including even parts that are unconstitutional or that have been repealed."

When the above rules of interpretation are applied, the statute as a whole will be found to be in strict harmony with the established decisions concerning trade-mark rights.

Under any and every recognized rule for the interpretation of statutes the phrase in question of Section 5 of the Trade-Mark Act should be so construed as to entitle petitioner to the registration of its trade-mark.

Previous Interpretations of Statute in Question.

The Trade-Mark Act of July 8, 1870, contained substantially the same restriction as that contained in Section 5 of the present Trade-Mark Act, and which the Commissioner held precludes the registration by petitioner of the trade-mark "Simplex" because of the corporate name Simplex Electric Heating Company. Section 79 of the Act of July 8, 1870, contained the following prohibition:

> "The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only . . ."

The quoted prohibition was held not to extend to the registration of a name of a person other than the applicant. Acting Commissioner Doolittle, in *ex parte Pace, Talbott & Co.*, 16 O. G., 909, held that the above quoted prohibition of the Trade-Mark Law of 1870 only prevented registration as a trade-mark of the name of the applicant, and did not prevent the registration of any other proper trade-mark on account of it being the name of some other person or concern than the applicant. In support of his position Mr. Doolittle referred to

Browne on Trade-Marks, and quoted therefrom the following relative to the construction of the phrase "merely the name of a person, firm, or corporation":

> "This has been construed to mean the name of the party applicant. In some instances the courts have held that the names of historical persons of note could be used as fancy names, and, therefore, be valid trade-marks. In one instance the proposed mark consisted of the word 'Alexina.' The Special Examiner refused registration, because 'Alexina' is merely the name of a woman, and cited instances. This decision was reversed on appeal to the Commissioner in person, who held that the name was an arbitrary symbol as used by the applicant.
>
> "In another case, where an applicant had used for the period of twenty-one years, as a trade-mark for bridle-bits and stirrups, the word 'Daniel,' as a fanciful name, it was admitted to registry. If this word 'Daniel' were the name of the applicant, it would not be valid for the purpose, but being a pure designation of fancy—meaning, mayhap, him who was thrown into the den of lions—there is no objection to it. Even if another person, whose real name is Daniel, were to set up in a similar business, he would not be permitted to stamp his goods with the simple name adopted as above stated, but would be compelled by a court of equity, if he used it at all, to use with it some distinguishing mark, or his initials, to avoid the possibility of confusion." (Secs. 348, 349.)

After making the above quotation from Browne on Trade-Marks Mr. Doolittle said:

> "I regard this a correct construction of the statute. In decisions cited by the Examiner, especially Porrier's case, the names of the applicants and manufacturers of the goods were sought to be incorporated as an essential part of the mark, and it was not held that the name of an individual, firm, or corporation, when merely arbitrary and fanciful in its signification, could not be the proper subject of a trade-mark. It is not intended that any proper word, whether the name of a person, firm, or cor-

poration, or geographical or other term, be denied registration as a trade-mark, unless the same is descriptive of the quality of the goods, or is the name of the applicant or manufacturer, or place of manufacture, or is deceptive.

"It would render the statute ridiculous to construe it literally. Although the names Socrates and Plato have been and may be the names of persons, yet, when applied to soap and chewing-tobacco, for instance, would hardly be regarded as objectionable trade-marks, if it appeared that they were not the names of the applicants or manufacturers."

The Trade-Mark Law of July 8, 1870, was followed by the Act of March 3, 1881, in which the interpretation which had been given to the phrase "merely the name of a person, firm, or corporation" in the law of 1870 was expressly embodied through the omission of such phraseology and the substitution of the exact statement:

"But no alleged trade-mark shall be registered unless the same appear to be lawfully used . . . ; nor which is *merely the name of the applicant.*"

Even the prohibition as to the mere name of the applicant was removed from the Act of 1881 by the supplemental Act of August 5, 1882, as follows:

"That nothing contained in the law (of March 3, 1881) shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."

As the same prohibition—namely, "merely in the name of a person, firm, or corporation"—occurs in Section 5 of the present Trade-Mark Act as occurred in the Trade-Mark Act of 1870, it should receive the same construction. As heretofore stated, Section 5 of the present Trade-Mark Act was before this court for con-

struction in *Thaddeus Davids Co.* v. *Davids*, 233 U. S., 461, 465, and the court said:

> "The fourth proviso, or ten-year clause, has manifest reference to marks which are not technical trade-marks; otherwise, it would have no effect. *The owner of a trade-mark valid at common law* and used in commerce with foreign nations, or among the several States, or with Indian tribes, *may obtain its registration under the act* without showing the user of ten years required by this clause. Sections 1, 2. Congress evidently had in mind the fact that marks, although not susceptible of exclusive appropriation at common law, frequently acquired a special significance in connection with particular commodities; and the language of the fourth proviso was carefully chosen in order to bring within the statute those marks which, while not being technical trade-marks, had been in 'actual and exclusive use' as trade-marks for ten years next preceding the passage of the act." (Italics ours.)

The above statement of this court is directly opposed to the lower court's interpretation of the phrase "merely the name of an individual, firm, corporation, or association." The Commissioner has not questioned the validity of petitioner's trade-mark "Simplex" at common law, nor that petitioner has used it in commerce among the several States, and yet he has refused registration thereof. While this court was not called upon to specifically construe the exact portion of Section 5 here in question, yet its statement above quoted relates to the whole section, and clearly indicates that it did not consider that anything in Section 5 could prevent the owner of a trade-mark valid at common law from obtaining registration of it.

Stare Decisis.

Sixty or more individuals or concerns have acquired statutory rights to the trade-mark "Simplex" as applied to various classes of merchandise through their registrations. Petitioner has acquired a property right at common law to the use of its trade-mark "Simplex" as applied to merchandise to which it has applied it. On the other hand, the Simplex Electric Heating Company has, neither at common law nor through registration, acquired any right to the trade-mark "Simplex" which would be prejudiced by the registration of the said trade-mark by petitioner. The decision of the lower court in the Ramey case was to the effect that the Simplex Electric Heating Company was entitled to exclusive right to the word "Simplex" as applied to those classes of goods to which it had first appropriated it. Any right which the said company acquired through the said decision of the Court of Appeals of the District of Columbia is in nowise invaded by the registration by petitioner of the said word as a trade-mark for classes of merchandise to which it was first to appropriate such name as a trade-mark.

An even broader application of the doctrine of *stare decisis* supports petitioner's interpretation of the phrase in question of the Trade-Mark Law. The law of trade-marks, both at common law and statutory, has consistently recognized the right of the one who first adopted and used a given trade-mark, and has protected it from the use of its trade-mark by others on goods of the same descriptive properties. The law of trade-marks, or unfair competition in trade, has never recognized the exclusive right of anyone in a word or mark as applied to any other class of goods than those on

which it has used it, nor has the exclusive right to a word merely because it forms part of a corporate name been recognized, except to the extent of preventing fraud or deception.

The law of *stare decisis* technically is limited to following an erroneous decision where property rights have thereby accrued, but is inapplicable where greater injury would be done by following an erroneous decision than by correcting it. If there has been any decision contrary to the interpretation for which petitioner contends of the statute in question, more harm would be done in following such decision than in correcting it, if this court is convinced that it is wrong. On the other hand, if the court is in doubt as to the correctness of the interpretation of the statute in question which petitioner contends for, such doubt should be resolved in petitioner's favor, in view of the long-established common-law right of petitioner to this trade-mark for the particular mechanism to which it has appropriated it, and in view of the well-recognized law of trade-marks, which is inconsistent with the interpretation of the statute given by the Court of Appeals of the District of Columbia.

Summary.

1. Petitioner has a common-law right to "Simplex" as a trade-mark for vehicles and such parts thereof as bolsters, couplers, brakes, as it was the first to adopt and use the said trade-mark on such classes of merchandise.

2. Petitioner, therefore, is entitled to registration of the trade-mark, as it is the intent and purpose of the Trade-Mark Law to register valid common-law trade-marks.

3. The Simplex Electric Heating Company has no exclusive right to the word "Simplex" as a trade-mark on any merchandise other than that to which it was the first to apply and use it. It has never used the said trade-mark on the merchandise for which petitioner has appropriated it.

4. The fact that the Simplex Electric Heating Company adopted as part of its corporate name the previously old and extensively used word "Simplex" gives said company no exclusive right to "Simplex" except when used as part of its name, and only then as against the fraudulent use of its name by others.

5. "Simplex" is not "merely" the name of the Simplex Electric Heating Company, and hence its registration by petitioner is not prohibited by Section 5 of the Act of 1905, even if construed to preclude registration of a trade-mark which is "merely" the name of a corporation engaged in an entirely different industry.

6. Section 5 of the Act of 1905, when construed by long and well-recognized rules of statute interpretation, entitles petitioner to registration of "Simplex" as a trade-mark for the merchandise to which it first applied and used it.

7. Petitioner has acquired a common-law property right in the trade-mark "Simplex" as applied to merchandise to which it has appropriated it, and under the rule of *stare decisis* is entitled to its registration.

Conclusion.

The construction of the statute in question by this court is a matter of great importance to many American manufacturers who are deprived, under the construction given thereto by the Court of Appeals of the District of Columbia, of the benefits and advantages of regis-

tering trade-marks in which they have acquired valuable property rights at common law, and which it is the purpose and intent of the Trade-Mark Law to protect.

Respectfully,

GEORGE L. WILKINSON,
Counsel for Petitioner.

CHICAGO, ILLINOIS.
June 20, 1919.

In the Supreme Court of the United States.

OCTOBER TERM, 1920.

AMERICAN STEEL FOUNDRIES, PETITIONER,
v.
THE COMMISSIONER OF PATENTS. } No. 131.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

STATEMENT ON BEHALF OF THE COMMISSIONER OF PATENTS.

This case presents for consideration the question whether the Court of Appeals of the District of Columbia correctly interpreted section 5 (b), Trade-Mark Act of February 20, 1905, in affirming the Commissioner of Patents in his refusal to register the word "Simplex" as a trade-mark for car-brake beams.

While it is the Attorney General's duty to represent the Commissioner of Patents, the Commissioner obviously needs no defense in the present case, since in making the ruling here in question he merely followed previous decisions of the Court of Appeals by which he was bound. Moreover, no interest of the Government is directly involved and it does not appear to be incumbent upon the Attorney General to

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participate in a case of this character which is, in fact, a controversy between individuals both of whom are represented by able counsel.

The Attorney General, therefore, submits the case without brief or argument on behalf of the Commissioner of Patents.

Respectfully submitted.

WM. L. FRIERSON,
Solicitor General.

FRANK DAVIS, JR.,
Assistant Attorney General.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1919.

No. 421.

(No. 131, October Term, 1920.)

AMERICAN STEEL FOUNDRIES,
Petitioner,

vs.

ROBERT F. WHITEHEAD, Commissioner of Patents,
Respondent.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR PETITIONER.

STATEMENT OF THE CASE.

Question Presented.

The sole question presented is the construction of Section 5 of the Trade-Mark Statutes. The construction given by the Court of Appeals of the District of Columbia precludes the Commissioner of Patents from registering a common-law trade-mark which forms part

of the name of a corporation, even though the business of the corporation relates exclusively to merchandise in an entirely different and non-competing class from that on which the trade-mark is used. Petitioner uses the trade-mark "SIMPLEX" on railway car brakes; while the corporation, the Simplex Electric Heating Company, manufactures and sells electrically heated devices for household use.

The Facts.

(1) On May 19, 1917, petitioner, American Steel Foundries, filed an application in the United States Patent Office for the registration of the trade-mark "SIMPLEX" as applied to brake rigging, brake heads, brake beams, brake shoes, brake hangers, and clasp brakes, in Class 19, Vehicles Not Including Engines.

(2) On July 19, 1917, the Examiner of Trade-Marks in the United States Patent Office refused registration of petitioner's trade-mark in view of the ruling in *ex parte* Simplex Electric Heating Company, 123 MS. D., 114. The ruling referred to had been made by the Commissioner of Patents in granting a petition of Simplex Electric Heating Company, and was to the effect that the Examiner of Trade-Marks be instructed to reject any application for registration of "SIMPLEX" as a trade-mark. The ruling of the Commissioner was pursuant to a decision of the Court of Appeals of the District of Columbia in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400.

(3) On October 27, 1917, petitioner, American Steel Foundries, filed a request for reconsideration of the refusal of the Examiner of Trade-Marks to register its trade-mark, and, in support thereof, presented the argument that the merchandise to which petitioner had applied its trade-mark "SIMPLEX" was not of the same class, or of the same descriptive properties as any mer-

chandise manufactured or sold by the Simplex Electric Heating Company.

(4) On November 2, 1917, the Examiner of Trade-Marks again refused registration of petitioner's trade-mark "on the grounds stated in the first Office letter of July 19, 1917; the decision therein cited is controlling on the Examiner."

(5) On November 21, 1917, petitioner appealed to the Commissioner of Patents in person from the refusal of the Examiner of Trade-Marks to register its trade-mark, which appeal was duly perfected and orally argued before the then Assistant Commissioner of Patents.

(6) On February 23, 1918, the then Assistant Commissioner of Patents rendered a decision affirming the refusal of the Examiner of Trade-Marks to register petitioner's said trade-mark, and in his opinion stated:

> "I am inclined to agree with this applicant's contention that the 'mere name' referred to in the statute means a name to which the corporation has some claim as to its own property; but as I understand it the Court has held that this is the case with 'Simplex,' the name of the Simplex Electric Heating Company. Therefore, on the Court's construction of the wording of the statute, the applicant's mark must be refused registration. The Examiner's ruling is sustained."

(7) On March 29, 1918, petitioner notified the Commissioner of Patents of its appeal to the Court of Appeals of the District of Columbia, which appeal was duly perfected and orally argued before said court.

(8) On May 5, 1919, a decision was rendered by the Court of Appeals of the District of Columbia affirming the refusal of the Assistant Commissioner of Patents to register petitioner's trade-mark.

(9) On June 23, 1919, the petition for a writ of certiorari was filed, which was granted on October 13, 1919, and the writ issued on October 16, 1919.

Statute Involved.

Section 5 of the Act of February 20, 1905, authorizing the registration of trade-marks, is as follows:

> "That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> "(*a*) Consists of or comprises immoral or scandalous matter.
>
> "(*b*) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant; Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided,* That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided,* That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name

or term, shall be registered under the terms of this Act: *Provided further,* That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing: *And provided further,* That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further,* That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof."

BRIEF.

The sole ground of refusing registration is that petitioner's trade-mark "Simplex" consists merely in the name of a corporation—namely, the Simplex Electric Heating Company.

There is no contention that petitioner's trade-mark is anticipated, or that the said trade-mark is not the common-law property of petitioner as applied to the class of merchandise to which it has applied it. The Examiner of Trade-Marks in his action of July 19, 1917 (R. 5) stated:

> "A search in Class 19 fails to show that the mark is anticipated."

Petitioner in its amended statement (R. 10) alleges a continued use of the trade-mark Simplex in its business, and in the business of its predecessors, since on or about August 1, 1897. This statement is supported by petitioner's prior registration of the same trade-mark, No. 73,250, April 6, 1909, for railway car couplers in Class 19, Vehicles, which has been continuously used since June

1, 1907 (R. 19), and by the prior registration of the same trade-mark by petitioner's predecessors, Simplex Railway Appliance Co., for railway car bolsters in Class 19, Vehicles, which has been continuously used since August 1, 1897 (R. 21).

There is no contention that the Simplex Electric Heating Company, or any other company, has appropriated the trade-mark "Simplex" for merchandise of the same descriptive properties as the merchandise for which the trade-mark has been appropriated by petitioner.

There is no contention that petitioner has not acquired a good and valid common-law right to the said trade-mark as applied to merchandise in Class, 19, Vehicles.

The sole question presented for consideration is, therefore, whether the phrase "That no mark which consists merely of the name of an individual, firm, corporation, or association . . . shall be registered under the terms of this Act," occurring in Section 5 of the Act of February 20, 1905, precludes the Commissioner of Patents from registering a trade-mark which conforms to all of the requirements and possesses all of the characteristics necessary to a valid common-law trade-mark.

Points of Law to Be Discussed.

1. Purpose and intent of the trade-mark law.
2. Common-law right of petitioner to "Simplex" as a trade-mark for vehicles.
3. Simplex Electric Heating Company has no exclusive right to "Simplex" as a trade-mark on any goods other than those to which it has appropriated it.
4. Simplex Electric Heating Company by virtue of its name has no exclusive right to the word "Simplex," but is merely entitled to protection from fraudulent or deceptive use of its name by others.

5. Section 5 of the Trade-Mark Act cannot, under the following well-established rules for interpreting statutes, be so construed as to bar petitioner's registration:

(*a*) "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them." *Caminetti* v. *United States,* 242 U. S., 470, 485.

(*b*) "Where a particular construction of a statute will occasion great inconvenience or produce inequality or injustice, that view is to be avoided if another and more reasonable interpretation is present in the statute." *Knowlton* v. *Moore,* 178 U. S., 77.

(*c*) "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation." *Caminetti* v. *United States, supra.*

(*d*) "It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers." *Holy Trinity Church* v. *United States,* 143 U. S., 457, 459.

(*e*) "The enacting clause is, of course, the principal part of the statute, and, as its terms may be presumed to have embodied the main object of the act, the proviso should be strictly construed." 36 Cyc., 1161.

6. Previous interpretations of the statute in question.

7. *Stare decisis.*

Purpose and Intent of the Trade-Mark Law.

This court in *Elgin National Watch Co.* v. *Illinois Watch Co.,* 179 U. S., 665, 673, in defining the term "trade-mark," said:

"The term has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of

> particular manufacturers of the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."

The object and purpose of the trade-mark law are to confer upon the owner of a valid common-law trade-mark a statutory right to such trade-mark, together with certain advantages which flow therefrom and which are not derived from the common-law right. A registration under the trade-mark statute is *prima facie* evidence of ownership; it permits the owner to protect his rights in the Federal Courts regardless of diverse citizenship and the amount involved; it renders it unnecessary for him to prove a fraudulent knowledge and intent on the part of an infringer of his trade-mark; and it enables him to obtain registration of his mark in foreign countries.

This court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S., 461, 465, construing the section of the trade-mark law here in question—namely, Section 5—said:

> "The owner of a trade-mark valid at common law and used in commerce with foreign nations, or among the several States, or with Indian tribes, may obtain its registration under the Act without showing the user of ten years required by this clause."

The clause referred to is that which permits registration of trade-marks, otherwise unregistrable, which have been in actual and exclusive use by the applicant for ten years previous to the passage of the Act.

Mr. Justice Miller, speaking for this court in the Trade-Mark Cases, 100 U. S., 82, 92, described the trade-mark laws then in force as follows:

> "It is sufficient at present to say that they provide for the registration in the Patent Office of any device in the nature of a trade-mark to which any person has by usage established an exclusive right, or which the person so registering intends to appropriate by that act to his exclusive use; and they make the wrongful use of a trade-mark, so registered, by any other person, without the owner's permission, a cause of action in a civil suit for damages."

Not only has it been the purpose and intent of previous Trade-Mark Acts to extend statutory protection through registration to one who has acquired a common-law right to a trade-mark, but the committee on patents of the House of Representatives, in their report recommending the passage of the present act, said, in reference to the particular section here in question, as follows:

> "In the past there has been considerable complaint in regard to what could be registered under the existing law as a trade-mark. Much of the time of the committee in the hearing of the bill has been consumed in a discussion upon this particular feature of the legislation. *Sec. 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark.*" (Italics ours.)

It, therefore, being well established that it is the purpose and intent of the trade-mark law to register trade-marks to which the applicant has acquired a common-law right, it becomes pertinent to consider, first, whether petitioner has acquired a common-law right to the trade-mark "Simplex" as applied to merchandise in the general class of vehicles; and, second, whether the wording of the present trade-mark law must be so construed as to prevent Section 5 of the Act of 1905 from accomplishing the recognized purpose and intent of the trade-mark law.

Common-Law Right of Petitioner to "Simplex" as a Trade-Mark for Vehicles.

The trade-mark "Simplex" was originally adopted and used by petitioner's predecessor, Simplex Railway Appliance Company, for railway car bolsters, in Class 19, Vehicles, on August 1, 1897. Petitioner since June 1, 1907, has continuously used the said trade-mark on railway car couplers, in Class 19, Vehicles, and has since April 16, 1917, continuously used the said trade-mark in railway brakes in the same Class 19, Vehicles.

Petitioner's trade-mark fully complies with the requirements of the law well stated by this court in its recent decision in *Estate of P. D. Beckwith* v. *Commissioner of Patents*, 252 U. S., 538, from which the following quotation is made:

> "It was settled long prior to the Trade-Mark Registration Act that the law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade; this for the reason that the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients, or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public."

In order to defeat petitioner's common-law right to the said trade-mark as applied to merchandise in Class 19, Vehicles, it is necessary that it should appear that some other corporation, firm or individual had previously adopted it and has continuously used it on the same class of merchandise, or on "merchandise of the

same descriptive properties." The fact that the said trade-mark may have been previously adopted and used by others on merchandise of other descriptive properties in no way militates against petitioner's common-law right to said trade-mark as applied to vehicles and to all merchandise included in such general class. The use by different parties of the same trade-mark on merchandise of the *same* descriptive properties is "likely to cause confusion or mistake in the mind of the public or to deceive purchasers," and hence is properly prohibited both by statute and by common law.

Although the trade-mark "Simplex" has been adopted and used by some sixty parties, as indicated by the registrations appearing in the record of D. C. Court of Appeals in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400, there is no contention that the appropriation of the said trade-mark by petitioner to merchandise in the classes of vehicles is likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. Under the above state of facts petitioner has acquired a valid common-law right to the said trade-mark. This court, in *Canal Co.* v. *Clark*, 80 U. S., 311, 322, in considering the question of common-law trade-marks, said:

> "Undoubtedly words or devices may be adopted as trade-marks which are not original inventions of him who adopts them, and courts of equity will protect him against any fraudulent appropriation or imitation of them by others. Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions. Words in common use, with some exceptions, may be adopted, *if at the time of their adoption, they were not employed to designate the same, or like articles of production.* The office of a trade-mark is to point out distinctively the origin, or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer." (Italics ours.)

To the same effect is the following statement by this court:

> "It (the trade-mark) may consist in any symbol, or in any form of words; but, as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark which, from the nature of the fact, conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose." *Standard* v. *Trinidad*, 220 U. S. at page 453; 31 Sup. Ct. at page 457 (55 L. Ed. 536).

Petitioner's common-law right to the trade-mark "Simplex" as applied to merchandise in the class of vehicles is within all of the authorities, and is not contested by the Patent Office.

Simplex Electric Heating Company Has No Exclusive Right to "Simplex" as a Trade-Mark on Any Goods Other Than Those to Which It Has Appropriated It.

The fact that the Simplex Electric Heating Company has adopted and used the trade-mark "Simplex" is no bar to the recognition of petitioner's right thereto when applied to merchandise in the class of vehicles. The Simplex Electric Heating Company has never adopted and used the said trade-mark on merchandise in the class of vehicles, or in any class of merchandise of the same descriptive properties. The Simplex Electric Heating Company was not incorporated until 1902, five years subsequent to the adoption and use of the trade-mark "Simplex" by petitioner's predecessor. The Simplex Electric Heating Company was organized to take over that part of the business of the Simplex Electrical Company which resided in the manufacture and sale of electrically heated devices. It does not appear

that said company has ever used the trade-mark "Simplex" on any other class of merchandise. From 1898 until 1902 the Simplex Electrical Company had manufactured and sold electrically heated devices, and prior thereto such devices had been manufactured and sold by the American Electric Heating Company, which in 1896 had accumulated some two or three hundred patents relating to electric heating devices. These facts appear in the opinion of the Court of Appeals of the District of Columbia in *Simplex Electric Heating Co.* v. *Ramey Co.*, 46 App. D. C., 400, but it does not appear from the opinion of the court in said case that the Simplex Electric Heating Company used the trade-mark "Simplex," or that the said trade-mark was used by any predecessor of the Simplex Electric Heating Company prior to 1898. Whether or not the trade-mark "Simplex" had been used by the predecessor of the Simplex Electric Heating Company prior to August 1, 1897, when it was adopted and used by petitioner's predecessor, is wholly immaterial, as in any use of such trade-mark by the Simplex Electric Heating Company or its predecessors was on merchandise of different descriptive properties from vehicles. The Simplex Electric Heating Company, therefore, has never acquired any right to the trade-mark "Simplex" as applied to vehicles, or any parts thereof. The said company's right to the trade-mark "Simplex" is limited to merchandise of the same descriptive properties as that on which it has used the said trade-mark, and it has no right to said trade-mark as applied to merchandise of any other descriptive properties.

This court, in *Canal Co.* v. *Clark*, *supra*, said (p. 323):

> "No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself."

This court in *Columbia Mill Co.* v. *Alcorn*, 150 U. S., 460, 463, stated as one of the essential requisites to a valid trade-mark the following:

> "That the exclusive right to the use of the mark or device claimed as a trade mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles of production."

This court again defined the scope of a trade-mark in *Standard Paint Co.* v. *Trinidad Asphalt Co.*, 220 U. S., 446, 454, as follows:

> "A trade mark, it was hence concluded, 'must therefore be distinctive in its original signification, point to the origin of the article, or it must have become such by association.' But two qualifying rules were expressed, as follows: 'No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed.'"

This court in *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S., 403, 414, quoted with approval the following excellent summary of the law of trade-marks from the opinion of Vice Chancellor Sir Wm. Page Wood, in *Ainsworth* v. *Walmsley*, L. R., 1 Eq., 518, 524:

> "'This court has taken upon itself to protect a man in the use of a certain trade-mark as applied to a particular description of article. *He has no property in that mark per se, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade.* If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them, the court has

said that no one shall be at liberty to defraud that man by using that mark, and passing off goods of his manufacture as being the goods of the owner of that mark.'" (Italics ours.)

To the same effect is the recent decision of this court in *United Drug Co.* v. *Theodore Rectanus Co.*, 39 Sup. Ct., 48; 248 U. S., 90:

> "There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed. The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property except in connection with an existing business. *Hanover Milling Co.* v. *Metcalf*, 240 U. S. 403, 412-414, 36 Sup. Ct. 357, 60 L. Ed. 713."

This court, in *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S., 403, 415, held that the first adopter of the trade-mark "Tea Rose" as applied to flour was limited in its exclusive right to said mark to the territory in which it had sold the flour, and that it could not enforce its trade-mark against one who had later adopted and used the same trade-mark on flour in other territory. This court said:

> "Into whatever markets the use of a trade-mark has extended, or its meaning has become known, there will the manufacturer or trader whose trade is pirated by an infringing use be entitled to protection and redress. But this is not to say that the proprietor of a trade-mark, good in the markets where it has been employed, can monopolize markets that his trade has never reached, and where the mark signifies not his goods, but those of another."

The same rule announced by this court as to terri-

tory applies to classes of goods, and one who has adopted and used a trade-mark on one class of goods can no more enforce the said trade-mark against one who has later adopted it and used it on another class of goods, than can the originator of the trade-mark enforce it in territory in which he has not used it.

The Simplex Electric Heating Company, therefore, has, under well-established law, no right to the trade-mark "Simplex" as applied to any other goods than those to which it has appropriated it. It has never adopted and used the said trade-mark on vehicles, or parts thereof, and hence has no right which would be injured by the registration of the said trade-mark by petitioner. Furthermore, it has no right under its charter (R. 15) to engage in the manufacture or sale of vehicles or brakes for railway cars.

Simplex Electric Heating Company by Virtue of Its Name Has No Exclusive Right to the Word "Simplex."

It was evidently the intention of the portion of Section 5 of the Trade-Mark Act under consideration—namely, "no mark which consists merely in the name of an individual, firm, corporation, or association . . . shall be registered"—to recognize the common-law right of a corporation to protection against fraudulent use of its name by others.

The general rule governing the supervision of equity over the names of corporations was well stated in *Higgins Co.* v. *Higgins Soap Co.*, 144 N. Y., 462, as follows:

> "In respect to corporate names, an injunction lies to restrain the simulation and use by one corporation of the name of a prior corporation which tends to create confusion, and to enable the later corporation to obtain, by reason of the similarity

of names, the business of the prior one. The courts interfere in these cases, not on the ground that the state may affix such corporate names as it may elect to the entities it creates, but to prevent fraud, actual or constructive."

The law was also well stated by Judge Bradley in *Celluloid Mfg. Co.* v. *Cellonite Mfg. Co.*, 32 F. R., 94, 97, as follows:

> "Fair competition in business is legitimate, and promotes the public good; but an unfair appropriation of another's business, by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or any other way, is justly punishable by damages, and will be enjoined by a court of equity."

The right of a corporation to its name extends no further, and does not give to a corporation the exclusive right to a word which it may have adopted as part of its name. If it has used such a word as a trade-mark applied to certain merchandise, it is protected in the use of such word, not because it is part of its name, but because it has a common-law right to it as a trade-mark. A generic word embodied in a corporate name is not entitled to protection in equity. The same principle which protects a corporation in the use of its own name operates to prevent the corporation from interfering with the use by others of that part of its name which was previously known to and used by others, and to which it has no more right than they have.

The Court of Appeals for the Seventh Circuit, in *Keystone Oil & Mfg. Co.* v. *Buzby*, 219 Fed. Rep., 473, 476, in holding that the plaintiff did not acquire exclusive right to the word "Keystone" as a trade-mark merely because it formed part of its corporate name, said:

> "The contention on behalf of the appellee for support of the decree, as we understand it, is this

in effect: That the word 'Keystone' has been so appropriated by the appellee in his business that his rights have become exclusive for its use in the marking and sale of lubricants. Such broad view, however, is untenable under the entire current of authorities. Words which are common to the public cannot be thus appropriated for exclusive use, beyond the limited extent recognized for the protection either of trade-marks against infringers or of trade-names against deceptive imitators. In the leading trade-mark case of *McLean* v. *Fleming*, 96 U. S., 245, 252, 24 L. Ed. 828, speaking in reference to trade-mark rights of a person in his own name, the opinion states the rule that:

> "'Such a party is not, in general entitled to the exclusive use of a name merely as such, without more. . . . Instead of that, he cannot have such a right, even in his own name, as against another person of the same name, unless such other person uses a form of stamp or label so like that used by the complaining party as to represent that the goods of the former are of the latter's manufacture.'
>
> ". . . No person can acquire exclusive rights to employ any name or word, as part of his trade-name; but one may acquire reputation for his business or goods under any designation he has adopted therefor, and other traders are excluded under the rule from filching his trade by deceptive use of like designation."

The word "Simplex" is an ordinary English word directly adopted from the Latin. It appears in Ogilvie's Imperial Dictionary, published in London in 1882; in Cassel's Encyclopedic Dictionary, published in New York, New York, in 1887; and in the Standard Dictionary, published in 1895. It is, therefore, a word which was well known long prior to any alleged adoption of it as a part of the corporate name of the Simplex Electric Heating Company.

It appears from the records of the Court of Appeals of the District of Columbia in *Simplex Electric Heating*

Company v. *Ramey Co., supra,* that the word "Simplex" has been registered at least sixty times, as applied to various classes of merchandise. Registration No. 56,842, October 23, 1906, Jas. Chadwick & Bro., shows that a trade-mark comprising the word "Simplex" has been in use on sewing thread since 1859. On October 28, 1890, "Simplex" was registered as a trade-mark for insulated wire by a firm called the Simplex Electrical Company, registration No. 18,552.

It also appears in the said records that more than sixty corporations listed in the directories of a number of the largest cities in this country have names of which the word "Simplex" form a part. The Simplex Gas Machine Co., of New York, was incorporated October 16, 1884; the Simplex Mfg. Co., of New York, on October 14, 1890; the Simplex Dairy Co., of West Virginia, February 5, 1896; and the Simplex Railway Appliance Co. of Illinois, petitioner's predecessor, on July 30, 1897.

The Simplex Electric Heating Company, therefore, was not the first to use the word "Simplex" as part of a corporate name, nor was it the first to use the word "Simplex" as a trade-mark.

The word "Simplex" is not only not *merely* the name of a corporation, the Simplex Electric Heating Company, but it is not the distinguishing name of said corporation. The name "Simplex" is just as distinctive of the various other sixty or more corporations in the names of which it appears, and many of which were incorporated before the Simplex Electric Heating Company, as it is of the latter corporation. The word "Simplex" does not identify any corporation in particular, because it is equally the name of various corporations. If the "Simplex Company" were referred to without any other identifying words it would not be known to what corporation reference was made.

The Simplex Electric Heating Company merely adopted as part of its name a word already in common use in names and trade-marks.

The word "Simplex" no more identifies the name of the Simplex Electric Heating Company than do the words "Electric" or "Heating." In fact, in order to distinguish the name of the said company from the Simplex Electric Company, it was necessary that the word "Heating" should be added. This name, if any, is therefore the essential distinguishing feature in the name of the said company.

The Simplex Electric Heating Company acquired no common-law right generally to the word "Simplex" through its adoption of such word as part of its name, and it could not in a court of equity enjoin the use of such name by others unless intentionally used to deceive the public and to injure the said company. The phrase in Section 5 of the Trade-Mark Act under discussion was clearly only intended to recognize the common-law right of a corporation to its name and its equitable right to be protected from the fraudulent use of its name.

Section 5 of the Trade-Mark Act Cannot, Under the Following Well-Established Rules for Interpreting Statutes, Be So Construed as to Bar Petitioner's Registration.

The phrase in Section 5 of the Trade-Mark Act under discussion, namely,

> "no mark which consist merely in the name of an individual, firm, corporation, or association . . . shall be registered under the terms of this Act,"

when interpreted by any and all of the recognized rules for the interpretation of statutes constitutes no bar to the registration by petitioner of the trade-mark "Sim-

plex" as applied to the goods to which it has appropriated it, as it distinguishes such goods "from other goods of the same class."

The first rule as to the interpretation of statutes is well stated by this court in *Caminetti* v. *United States, supra,* as follows:

> "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them."

The trade-mark sought to be registered, "Simplex," is one of the three words of the name of the Simplex Electric Heating Company. Is the one word "Simplex" "*merely*" the name of the Simplex Electric Heating Company? To so hold would be to utterly disregard the ordinary and usual meaning of the word "merely."

The Century Dictionary defines the word "merely" as follows:

> "1. Absolutely; wholly; completely; utterly.
> "2. Simply; solely; only."

Thus the word "merely" in the context under discussion must mean one of two things—namely, that the trade-mark sought to be registered must be something other than the sole verbal feature of a party's name; or that the word must be more than a name in the sense that its inherent character is such that it may become a trade-mark; that is to say, it is sufficiently arbitrary or fanciful in its application to entitle the user to sequester it in the particular line of manufacture in which he is engaged.

That the word "Simplex" is arbitrary and fanciful, and not "merely" a name in the sense of this interpretation of the expression, is conclusively shown by the fact that it has been recognized and registered as an arbitrary, fanciful name or trade-mark in the numerous instances cited in the record in *Simplex Electric Heating Co.* v. *Ramey Co., supra.*

That the word "Simplex" (taking the other interpretation of the expression) does not constitute absolutely, or wholly, or completely, or utterly, or simply, or solely, or only, the name of the Simplex Electric Heating Company is too obvious to need argument. In order to refuse registration of petitioner's trade-mark "Simplex" it is necessary to amend the phrase of Section 5 of the Trade-Mark Act under consideration by eliminating the word "merely" and by inserting after the word "consists" the phrase "of part of," so that the said phrase will read:

> "No mark which consists *of part* of the name of an individual, firm, corporation, or association . . . shall be registered under the terms of this Act."

The recognized rules of statute interpretation do not permit the language in which the statute is stated to be so judicially amended.

It is submitted, in fact, that when the Simplex Electric Heating Company registered its trade-mark "Simplex Quality" on September 11, 1906, Section 5 of the Trade-Mark Act had not been amended by adding thereto the last proviso, namely:

> "That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof."

The law, therefore, at that time precluded the registration as a trade-mark *merely* the name of a corporation, whether said corporation was the applicant or not. In registering the said trade-mark, in which the only registrable word is "Simplex," the Patent Office necessarily ruled that the mark "Simplex" was not merely the name of the Simplex Electric Heating Company. The ruling of the Patent Office in registering the said trade-mark, and thereby holding that the word "Simplex" was not merely the name of the Simplex Electric Heating Com-

pany, undoubtedly properly construed the trade-mark law, and should have followed its precedent by registering petitioner's trade-mark.

Under the elemental rule of statute interpretation petitioner is entitled to register its trade-mark "Simplex," as it is not "merely the name" of the corporation, Simplex Electric Heating Company, or of any other corporation.

Another recognized rule which controls the construction of statutes is that where a particular construction will cause injustice, a more reasonable interpretation must be given. This principle was reiterated by this court in *Knowlton* v. *Moore*, 178 U. S., 41, 77, as follows:

> "We are, therefore, bound to give heed to the rule, that where a particular construction of a statute will occasion great inconvenience or produce inequality and injustice, that view is to be avoided if another and more reasonable interpretation is present in the statute. *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S., 1, 37; *Wilson* v. *Rousseau*, 4 How., 646, 680; *Bloomer* v. *McQuewan*, 14 How., 539, 553; *Blake* v. *National Banks*, 23 Wall., 307, 320; *United States* v. *Kirby*, 7 Wall., 482, 486."

This court emphasized the importance of this rule of statute interpretation in connection with the trade-mark law under consideration as follows:

> " . . . Of course, refusal to register a mark does not prevent a former user from continuing its use; but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal construction of the act, designed as it is to promote the domestic and foreign trade of our country." *Estate of P. D. Beckwith, Inc.*, v. *Commissioner of Patents*, 40 Supreme Court Rept. 414; 252 U. S., 538.

If Section 5 of the Trade-Mark Law is construed as has been done by the Court of Appeals of the District of Columbia, injustice will be done petitioner. Petitioner un-

questionably has a common-law right to the trade-mark "Simplex" as applied to the various parts of railroad vehicles to which it has continuously applied it since August 1, 1897. It, therefore, has also acquired a statutory right to such trade-mark and to the benefits which are derived from registration of its trade-mark.

If registration is refused petitioner will be precluded from enforcing its right to its said trade-mark in the Federal courts, unless the statutory amount and diversity of parties are present. The refusal to register its trade-mark deprives it of the *prima facie* right thereto incident to registration and renders it necessary to prove a fraudulent intent on the part of an infringer.

Furthermore, the refusal to register petitioner's trade-mark renders it impossible to register it in many foreign countries, and hence leaves it a prey to scheming parties in foreign countries to register petitioner's trade-mark and prevent petitioner from shipping its merchandise bearing thereon its trade-mark into such foreign countries unless such piratical registrants are paid whatever sums they may demand.

The interpretation which the Court of Appeals of the District of Columbia has placed upon the section of the Trade-Mark Law in question, therefore, instead of benefiting American owners of trade-marks, benefits those scheming individuals who make it a practice to register American trade-marks in foreign countries, and prevent importation into such countries of the goods of the American legal owners of the trade-marks.

The Court of Appeals for the Second Circuit referred to the desirability of registering a trade-mark under the law of 1905, as follows:

> " . . . The desirability of registration under the act of 1905, to and among those in extensive and especially foreign trade, is very great, and need not

be dwelt upon; yet it is too well settled to need citation that a trade-mark is not the creature of registration, but the appendage or growth of a business." *Hercules Powder Co.* v. *Newton*, 266 Fed., 169.

The interpretation of the statute in question contended for, while necessary in order to avoid injustice to petitioner, will in nowise work an injustice to the Simplex Electric Heating Company, or any other person or concern. The said company is not entitled by common law to the trade-mark "Simplex" as applied to brake rigging, brake heads, brake beams, brake shoes, brake hangers, or clasp brakes, as it has never used the said trade-mark on such merchandise, nor can it in the future use the said trade-mark on such merchandise in view of the prior appropriation by petitioner. The registration of petitioner's trade-mark will in no wise result in any confusion of its goods with those of the Simplex Electric Heating Company, nor result in any possible infringement of the right of said company to the use of its corporate name.

Should there be a doubt as to the proper interpretation of the phrase in question of Section 5 of the Trade-Mark Law, that interpretation should be given which will be consistent with the intent and purpose of the law. In determining the intent and purpose of a law it was stated by this court in *Caminetti* v. *United States, supra:*

> "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation. *Blake* v. *National Banks*, 23 Wall. 307, 319; *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S. 1, 42; *Chesapeake and Potomac Telephone Co.* v. *Manning*, 186 U. S., 238, 246; *Binns* v. *United States*, 194 U. S. 486, 495."

The report of the Committee on Patents of the House of Representatives, in recommending the passage of the present Trade-Mark Act, is pertinent, therefore, in de-

termining whether Section 5 should be interpreted as contended for by petitioner, or as has been done by the Commissioner of Patents. The following quotation is for convenience here repeated from the report of the said committee:

> "In the past there has been considerable complaint in regard to what could be registered under the existing laws as a trade-mark. Much of the time of the committee in the hearing of the bill has been consumed in a discussion upon this particular feature of the legislation. Sec. 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark."

It, therefore, was the purpose and intent of Section 5 of the Trade-Mark Act of 1905 that it should permit

> *"registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark."*

The interpretation which has been given to Section 5 by the Court of Appeals of the District of Columbia prevents the registration to petitioner of its trade-mark "Simplex," although it clearly has established its common-law right to such trade-mark and has acquired a property right therein as applied to the merchandise to which it has appropriated it.

While it is contended on behalf of petitioner that the word "merely" cannot under any logical interpretation be held to mean that the word "Simplex" is merely Simplex Electric Heating Company, yet if there is any doubt it should be resolved in favor of petitioner's contention in view of the purpose and intent of the Trade-Mark Law, and particularly Section 5, as stated in the report of the Committee on Patents of the House of Rep-

resentatives in recommending the passage of the Trade-Mark Act.

Even if the words of Section 5 of the Trade-Mark Act in question were only susceptible of the literal meaning attributed to them by the Court of Appeals of the District of Columbia, nevertheless petitioner would be entitled to the registration of its trade-mark on the well-established ground that the words of a statute will be disregarded when they are in conflict with the spirit and intent of the law.

Justice Brewer, in rendering the opinion of this court in *Holy Trinity Church* v. *United States*, 143 U. S., 457, 459, forcefully stated this rule as to the interpretation of the statutes as follows:

> "It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers. This has been often asserted, and the reports are full of cases illustrating its application. This is not the substitution of the will of the judge for that of the legislator, for frequently words of general meaning are used in a statute, words broad enough to include an act in question, and yet a consideration of the whole legislation, or of the circumstances surrounding its enactment, or of the absurd results which follow from giving such broad meaning to the words, makes it unreasonable to believe that the legislator intended to include the particular act. . . . It is a case where there was presented a definite evil, in view of which the legislature used general terms with the purpose of reaching all phases of that evil, and thereafter, unexpectedly, it is developed that the general language thus employed is broad enough to reach cases and acts which the whole history and life of the country affirm could not have been intentionally legislated against. It is the duty of the courts, under those circumstances, to say that, however broad the language of the statute may be, the act, although within the letter, is not within the intention of the legislature, and therefore cannot be within the statute."

This court, in its recent decision in *Rock Springs Distilling Co. et al.* v. *Gaines Co.*, 38 Sup. Ct. Rep., 327; 246 U. S., 312, quoted with approval the following statement of Judge Sanborn, in *Layton Pure Food Co.* v. *Church & Dwight Co.*, 182 F. R., 35:

> "'Uniformity and certainty in rules of property are often more important and desirable than technical correctness.'"

Under the uniform and well-recognized rule of property in trade-marks petitioner is entitled to the exclusive right to the trade-mark "Simplex" when applied to merchandise for which it was first to appropriate it. The recognition of this property right of petitioner, through the registration of its trade-mark, is more important and desirable than any technical correctness in the construction of the words "merely in the name of an individual, firm, corporation, or association."

The enacting clause of Section 5 of the Trade-Mark Act of 1905 is:

> "No mark by which the goods of the owner of the mark may be distinguished from other goods of *the same class, shall be refused* registration as a trade-mark on account of the nature of such mark, unless such mark consists," etc.

This court in its recent decision in *Estate of P. D. Beckwith* v. *Commissioner of Patents*, 252 U. S., 538; 40 Sup. Ct., 414, said:

> "Since the proviso prohibits the registration not of merely descriptive words but of a 'trade-mark which consists . . . merely' (only) of such words—the distinction is substantial and plain—we think it sufficiently clear that such a composite mark as we have here does not fall within its terms. In this connection it must be noted that the requirement of the statute that no trade-mark shall be refused registration, except in designated cases, is just as imperative as the prohibition of the proviso against registration in cases specified."

The first exception or proviso embraces marks which as a matter of policy are of such universal import and significance as to render them immune to appropriation for trade-mark purposes by anyone. These marks include emblems and ensignia of states, nations and organizations of a social or fraternal nature which are to be deemed of a *higher order* in their relation to the political and social body than mere trading organizations. Obviously classification of goods are not involved in this prohibition, since questions of public policy rather than trade rights are the determining factor.

The second exception or proviso embraces marks which have already been appropriated for trade purposes and applied to goods "of the *same* descriptive properties." Priority of adoption in the *same class* of goods is the basis for this prohibition.

The third exception or proviso is the one with which we are most intimately concerned. This is an exception or proviso which is *in reduction* of the right to register specified in the main enacting clause, and must be thus construed *in relation thereto*. The main enacting clause is directed to distinguishing marks in *the same class*, and to that class only is the *exception* applicable. In the absence of this and other exceptions *all* marks which serve to distinguish the owner's goods "from other goods *of the same class*" would be entitled to registration, and mandamus proceedings would lie against the Commissioner for refusing to register.

The exception must thus be strictly construed, since it is in mitigation of a statutory right which would be otherwise enforceable. This reasoning is further emphasized by an analysis of the third exception itself.

That exception provides, among other things, that no mark "which consists . . . merely in words or devices which are *descriptive of the goods with which they are*

used or of the character or quality of such goods . . . shall be registered." It is obvious that this exception is not a wholesale prohibition against the use of words which in association with *other* kinds of goods may be considered *descriptive,* but that the prohibition is directed to words which are descriptive of the *particular* goods to which they are applied.

The above suggestions apply to almost any adjective. An adjective is intrinsically a qualifying or *descriptive* word, and yet a multitude of such words have been registered, and are always considered registrable if not descriptive of the *particular class* to which they are applied.

The fact that the third exception or proviso contains within itself a class limitation with respect to the registrability of descriptive words merely emphasizes the fact that everything specified within the third exception must be interpreted and construed as in reduction of rights *elsewhere conferred.* This is the only interpretation of this paragraph which is in harmony with the general tenor of the Trade-Mark Act and which will further the purpose of the legislature "to give a wide latitude to registry."

The main enacting clause having been framed with reference to the classification of goods, it necessarily follows that like considerations permeate every proviso to which they are *applicable,* especially when the statute is thus brought into harmony with the entire theory of trade rights long announced by the courts both in this country and Great Britain.

Furthermore, it is the only interpretation which is in harmony with the rules regarding the interpretation of statutes, which rules always recognize the fact that provisos and exceptions must be limited in their application to the particular subject-matter carved out or exempted from the operation of the main enacting clause.

The relation of a proviso to its context is thus set forth in 36 Cyc., 1161, as follows (italics ours):

> "A proviso is a clause engrafted on a preceding enactment for the purpose of restraining or modifying the enacting clause, or of excepting something from its operation which otherwise would have been within it, or of excluding some possible ground of misinterpretation of it, as by extending it to cases not intended by the legislature to be brought within its purview. The proviso is generally introduced by the word 'provided,' but its existence and effect are to be determined rather by its matter and substance than by its form. *It should be construed together with the enacting clause, with a view to giving effect to each and to carrying out the intention of the legislature as manifested in the entire act.* The enacting clause is, of course, the principal part of the statute, and, as its terms may be presumed to have embodied the main object of the act, the proviso should be strictly construed. The appropriate office of the proviso is to restrain or modify the enacting clause; and *not to enlarge it.*"

As further explaining the manner in which the statute should be construed, we find in 36 Cyc., 1128, the following statement:

> "It is a cardinal rule in the construction of statutes that effect is to be given, if possible, to every word, clause, and sentence. It is the duty of the court, so far as practicable, to reconcile the different provisions, so as to make them consistent and harmonious, and to give a sensible and intelligent effect to each."

And again, in 36 Cyc., 1131, the following (italics ours):

> "The words, phrases, and sentences of a statute are to be understood as used, not in any abstract sense, but *with due regard to the context*, and in that sense which best harmonizes with all other parts of the statute. In expounding one part of a statute therefore *resort should be had to every other part*, including even parts that are unconstitutional or that have been repealed."

When the above rules of interpretation are applied, the statute as a whole will be found to be in strict harmony with the established decisions concerning trade-mark rights.

Under any and every recognized rule for the interpretation of statutes the phrase in question of Section 5 of the Trade-Mark Act of 1905 should be so construed as to entitle petitioner to the registration of its trade-mark.

Previous Interpretations of Statute in Question.

The Trade-Mark Act of July 8, 1870, contained substantially the same restriction as that contained in Section 5 of the present Trade-Mark Act, and which the Commissioner held precludes the registration by petitioner of the trade-mark "Simplex" because of the corporate name Simplex Electric Heating Company. Section 79 of the Act of July 8, 1870, contained the following prohibition:

> "The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only . . ."

The quoted prohibition was held not to extend to the registration of a name of a person other than the applicant. Acting Commissioner Doolittle, in *ex parte Pace, Talbott & Co.*, 16 O. G., 909, held that the above quoted prohibition of the Trade-Mark Law of 1870 only prevented registration as a trade-mark of the name of the applicant, and did not prevent the registration of any other proper trade-mark on account of it being the name of some other person or concern than the applicant. In support of his position Mr. Doolittle referred to Browne on Trade-Marks, and quoted therefrom the following relative to the construction of the phrase "merely the name of a person, firm, or corporation":

"This has been construed to mean the name of the party applicant. In some instances the courts have held that the names of historical persons of note could be used as fancy names, and, therefore, be valid trade-marks. In one instance the proposed mark consisted of the word 'Alexina.' The Special Examiner refused registration, because 'Alexina' is merely the name of a woman, and cited instances. This decision was reversed on appeal to the Commissioner in person, who held that the name was an arbitrary symbol as used by the applicant.

"In another case, where an applicant had used for the period of twenty-one years as a trade-mark for bridle-bits and stirrups, the word 'Daniel,' as a fanciful name, it was admitted to registry. If this word 'Daniel' were the name of the applicant, it would not be valid for the purpose, but being a pure designation of fancy—meaning, mayhap, him who was thrown into the den of lions—there is no objection to it. Even if another person, whose real name is Daniel, were to set up in a similar business, he would not be permitted to stamp his goods with the simple name adopted as above stated, but would be compelled by a court of equity, if he used it at all, to use with it some distinguishing mark, or his initials, to avoid the possibility of confusion." (Secs. 348, 349.)

After making the above quotation from Browne on Trade-Marks, Mr. Doolittle said:

"I regard this a correct construction of the statute. In decisions cited by the Examiner, especially Porrier's case, the names of the applicants and manufacturers of the goods were sought to be incorporated as an essential part of the mark, and it was not held that the name of an individual, firm, or corporation, when merely arbitrary and fanciful in its signification, could not be the proper subject of a trade-mark. It is not intended that any proper word, whether the name of a person, firm, or corporation, or geographical or other term, be denied registration as a trade-mark, unless the same is descriptive of the quality of the goods, or is the name of the applicant or manufacturer, or place of manufacture, or is deceptive.

"It would render the statute ridiculous to construe

> it literally. Although the names Socrates and Plato have been and may be the names of persons, yet, when applied to soap and chewing-tobacco, for instance, would hardly be regarded as objectionable trade-marks, if it appeared that they were not the names of the applicants or manufacturers."

The Trade-Mark Law of July 8, 1870, was followed by the Act of March 3, 1881, in which the interpretation which had been given to the phrase "merely the name of a person, firm, or corporation" in the law of 1870 was expressly embodied through the omission of such phraseology and the substitution of the exact statement:

> "But no alleged trade-mark shall be registered unless the same appear to be lawfully used . . .; nor which is *merely the name of the applicant.*"

Even the prohibition as to the mere name of the applicant was removed from the Act of 1881 by the supplemental Act of August 5, 1882, as follows:

> "That nothing contained in the law (of March 3, 1881) shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."

As the same prohibition—namely, "merely in the name of a person, firm, or corporation"—occurs in Section 5 of the present Trade-Mark Act as occurred in the Trade-Mark Act of 1870, it should receive the same construction. As heretofore stated, Section 5 of the present Trade-Mark Act was before this court for construction in *Thaddeus Davids Co.* v. *Davids,* 233 U. S., 461, 465, and the court said:

> "The fourth proviso, or ten-year clause, has manifest reference to marks which are not technical trade-marks; otherwise, it would have no effect. *The owner of a trade-mark valid at common law* and used in commerce with foreign nations, or among the several States, or with Indian tribes, *may obtain its registration under the act* without showing the user of

> ten years required by this clause. Sections 1, 2. Congress evidently had in mind the fact that marks, although not susceptible of exclusive appropriation at common law, frequently acquired a special significance in connection with particular commodities; and the language of the fourth proviso was carefully chosen in order to bring within the statute those marks which, while not being technical trade-marks, had been in 'actual and exclusive use' as trade-marks for ten years next preceding the passage of the act." (Italics ours.)

The above statement of this court is directly opposed to the lower court's interpretation of the phrase "merely the name of an individual, firm, corporation, or association." The Commissioner has not questioned the validity of petitioner's trade-mark "Simplex" at common law, nor that petitioner has used it in commerce among the several States, and yet he has refused registration thereof. While this court was not called upon to specifically construe the exact portion of Section 5 here in question, yet its statement above quoted relates to the whole section, and clearly indicates that it did not consider that anything in Section 5 could prevent the owner of a trade-mark valid at common law from obtaining registration of it.

Stare Decisis.

Sixty or more individuals or concerns have acquired statutory rights to the trade-mark "Simplex" as applied to various classes of merchandise through their registrations. Petitioner has acquired a property right at common law to the use of its trade-mark "Simplex" as applied to merchandise to which it has applied it. On the other hand, the Simplex Electric Heating Company has, neither at common law nor through registration, acquired any right to the trade-mark "Simplex" which would be prejudiced by the registration of the said trade-mark by

petitioner. The decision of the lower court in the Ramey case was to the effect that the Simplex Electric Heating Company was entitled to exclusive right to the word "Simplex" as applied to those classes of goods to which it had first appropriated it. Any right which the said company acquired through the said decision of the Court of Appeals of the District of Columbia is in nowise invaded by the registration by petitioner of the said word as a trade-mark for classes of merchandise to which it was first to appropriate such name as a trade-mark.

An even broader application of the doctrine of *stare decisis* supports petitioner's interpretation of the phrase in question of the Trade-Mark Law. The law of trade-marks, both at common law and statutory, has consistently recognized the right of the one who first adopted and used a given trade-mark, and has protected it from the use of its trade-mark by others on goods of the same descriptive properties. The law of trade-marks, or unfair competition in trade, has never recognized the exclusive right of anyone in a word or mark as applied to any other class of goods than those on which it has used it, nor has the exclusive right to a word merely because it forms part of a corporate name been recognized, except to the extent of preventing fraud or deception.

The law of *stare decisis* technically is limited to following an erroneous decision where property rights have thereby accrued, but is inapplicable where greater injury would be done by following an erroneous decision than by correcting it. If there has been any decision contrary to the interpretation for which petitioner contends of the statute in question, more harm would be done in following such decision than in correcting it, if this court is convinced that it is wrong. On the other hand, if the court is in doubt as to the correctness of the interpretation of the statute in question which petitioner contends for, such doubt should be resolved in

petitioner's favor, in view of the long established common-law right of petitioner to this trade-mark for the particular mechanism to which it has appropriated it, and in view of the well-recognized law of trade-marks, which is inconsisent with the interpretation of the statute given by the Court of Appeals of the District of Columbia.

Trade-Mark Act of March 19, 1920.

Subsequent to the issuing of the writ of certiorari in this case an additional Trade-Mark Act was passed by Congress and was approved on March 19, 1920. The said additional Trade-Mark Act does not, however, in any way affect the petitioner's right to registration of its trade-mark "Simplex" under the act of February 20, 1905, and to thereby secure the benefits to be derived from such registration.

The additional Trade-Mark Act of 1920 authorizes the Commissioner of Patents to keep a register of

> "(*a*) all marks communicated to him by the international bureaus provided for by the convention for the protection of trade-marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, in connection with which the fee of $50 gold for the international registration established by article 2 of that convention has been paid, which register shall show a fac-simile of the mark; the name and residence of the registrant; the number, date, and place of the first registration of the mark, including the date on which application for such registration was filed and the term of such registration, a list of goods to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark.
>
> "(*b*) All other marks not registrable under the Act of February 20, 1905, as amended, except those

specified in paragraphs (*a*) and (*b*) of Section 5 of that Act, but which have been in bona fide use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof, upon or in connection with any goods of such proprietor upon which a fee of $10 has been paid to the Commissioner of Patents and such formalities as required by the said commissioner have been complied with: *Provided*, That trade-marks which are identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register."

Section (*b*) has been construed by the Solicitor of the Department of the Interior to mean that the Commissioner may register certain trade-marks which are precluded from registration by the various provisos contained in schedule (*b*) of Section 5 of the Act of 1905. This additional Trade-Mark Act, therefore, authorizes the registration of trade-marks which are not recognized by common law, such, for instance, as descriptive and geographical names or terms.

The Solicitor of the Department of the Interior in his opinion further held that marks registrable under the act of February 20, 1905, cannot be registered under Section (*b*) of the act of March 19, 1920. The registration of a trade-mark under the act of 1920 is therefore an adjudication on the part of the Patent Office that such mark is not registrable under the act of 1905, and the registration of a trade-mark under the act of 1920 is an admission by the proprietor of such mark that it is not registrable under the act of 1905. As the act of 1905 affords registration to all trade-marks good at common law, while trade-marks having no standing at common law are registrable under the act of 1920,

it is obvious that petitioner's trade-mark "Simplex" is not registrable under the act of 1920 if petitioner's contention, that its trade-mark is one good at common law, is sound.

Should a trade-mark good at common law, such as petitioner's trade-mark "Simplex" as applied to railway brakes, be registered under the act of 1920, such registration might prove embarrassing in a suit instituted against infringers of such trade-mark, inasmuch as registration under the law of 1920 might constitute an admission that it was not a good common law trade-mark.

While Section 16 of the act of 1905 provides "That the registration of a trade-mark under the provisions of this Act shall be *prima facie* evidence of ownership," the act of 1920 contains no such provision. A registrant under the law of 1920, therefore, does not derive the advantage of his registration being *prima facie* evidence of ownership.

Petitioner's trade-mark is one good at common law, and it is therefore entitled to registration under the act of 1905, and the fact that there has been enacted the additional Trade-Mark Law of 1920 should not deprive petitioner of its right to register its trade-mark under the law of 1905 and secure thereby the benefits and advantages therefrom, which could not be derived by registration under the law of 1920.

Summary.

1. Petitioner has a common-law right to "Simplex" as a trade-mark for vehicles and such parts thereof as bolsters, couplers, brakes, as it was the first to adopt and use the said trade-mark on such classes of merchandise.

2. Petitioner, therefore, is entitled to registration of

the trade-mark, as it is the intent and purpose of the Trade-Mark Law to register valid common-law trade-marks.

3. The Simplex Electric Heating Company has no exclusive right to the word "Simplex" as a trade-mark on any merchandise other than that to which it was the first to apply and use it. It has never used the said trade-mark on the merchandise for which petitioner has appropriated it.

4. The fact that the Simplex Electric Heating Company adopted as part of its corporate name the previously old and extensively used word "Simplex" gives said company no exclusive right to "Simplex" except when used as part of its name, and only then as against the fraudulent use of its name by others.

5. "Simplex" is not "merely" the name of the Simplex Electric Heating Company, and hence its registration by petitioner is not prohibited by Section 5 of the act of 1905, even if construed to preclude registration of a trade-mark which is "merely" the name of a corporation engaged in an entirely different industry.

6. Section 5 of the act of 1905, when construed by long and well-recognized rules of statute interpretation, entitles petitioner to registration of "Simplex" as a trade-mark for the merchandise to which it first applied and used it.

7. Petitioner has acquired a common-law property right in the trade-mark "Simplex" as applied to merchandise to which it has appropriated it, and under the rule of *stare decisis* is entitled to its registration.

8. Petitioner's right to registration of its common-law trade-mark under the act of 1905 is in no wise abrogated by the enactment of the additional Trade-Mark Law of 1920.

Conclusion.

It is respectfully submitted that petitioner is entitled to the registration of its trade-mark under the provisions of the act of 1905, and that the decision of the Court of Appeals for the District of Columbia should therefore be reversed.

GEORGE L. WILKINSON,
Counsel for Petitioner.

CHICAGO,
NOV. 12, 1920.

Office Supreme Court, U. S.
FILED
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JAMES D. MAHER,
CLERK.

Supreme Court of the United States.

October Term, 1919.

No. [redacted]181

AMERICAN STEEL FOUNDRIES,
PETITIONER,

v.

JAMES T. NEWTON, Commissioner of Patents,
RESPONDENT.

Motion by Simplex Electric Heating Company, as Real Party Respondent, to Appear, File a Brief, and Make Oral Argument.

NATHAN HEARD,
FREDERICK A. TENNANT,
Counsel for
Simplex Electric Heating Company.

JUDSON C. WELLIVER & SON, LAW PRINTERS, BOSTON.

Supreme Court of the United States.

OCTOBER TERM, 1919.

No. 421.

AMERICAN STEEL FOUNDRIES,
PETITIONER,
v.
JAMES T. NEWTON, COMMISSIONER OF PATENTS,
RESPONDENT.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Simplex Electric Heating Company, a Massachusetts corporation, respectfully moves this Honorable Court that it be allowed to appear, as the real party at interest in the above case, file a brief, and make oral argument in support of the decision of the Court of Appeals of the District of Columbia herein, upon the following grounds:

1. The respondent, James T. Newton, Commissioner of Patents, is only a formal respondent, and has no real adverse interest. The Commissioner of Patents in making the ruling sought to be reversed in this case has done so only because of, and because he was bound by, the prior decisions of the Court of Appeals of the District of Columbia construing the statute involved.

2. Simplex Electric Heating Company has the real adverse interest, and the protection heretofore af-

forded it by the statute involved would be destroyed should this Court reverse the construction thereof which has been given and maintained by the Court below in a long line of decisions.

3. The case now before this Court on the writ of certiorari originated in an application to the United States Patent Office for registration of the trade-mark SIMPLEX by the petitioner, American Steel Foundries, under the provisions of section 1 of the Act of February 20, 1905. Registration was refused upon this application by the Examiner of Trade Marks and an *ex parte* appeal taken from this refusal to the Commissioner of Patents in person as provided by section 8 of said Act. This *ex parte* appeal was decided against the petitioner by the Commissioner of Patents, and thereupon an appeal was taken to the Court of Appeals of the District of Columbia in accordance with the provisions of section 9 of said Act. That Court affirmed upon the *ex parte* appeal the refusal of the Commissioner of Patents to grant registration upon the petitioner's application.

4. The Commissioner of Patents has never found that American Steel Foundries is entitled to have its trade-mark registered under the provisions of the Act, and consequently has not caused the mark to be published in the Official Gazette of the Patent Office, and consequently no opportunity has been afforded for the Simplex Electric Heating Company to file an opposition, all as provided by section 6 of the said Act.

5. No one actively interested in opposing the contentions of the petitioner, American Steel Foundries, is now before this Court. The record herein shows

that no one appeared for the respondent to oppose before this Court the granting of the petition for the writ of certiorari. The Simplex Electric Heating Company received its first information of this matter after the granting of the writ through the courtesy of the Solicitor General of the United States, who called the attention of the Simplex Electric Heating Company to the action of this Court in granting the writ, and who suggested that the Simplex Electric Heating Company was more interested in the questions raised than was the Commissioner of Patents. The powers or the rights of the Commissioner of Patents will be in no way affected by the decision of this Court herein, and there is no consideration moving or obligation requiring the Solicitor General actively to oppose the contentions of the petitioner.

6. The construction of the section of the statute in question and its specific application to this particular mark SIMPLEX and to the corporate name of Simplex Electric Heating Company has twice been determined in contested cases to which it was a party, namely, *D. H. Burrell Company* v. *Simplex Electric Heating Company*, 44 Apps. D.C. 452, and *Simplex Electric Heating Company* v. *Ramey Company*, 46 Apps. D.C. 400, by the Court of Appeals of the District of Columbia.

7. Simplex Electric Heating Company has succeeded after long and vigorously contested litigation in preventing registration of the mark SIMPLEX in accordance with the provisions of the Trade-Mark Act as construed by the Court of Appeals of the District of Columbia. The right of the Simplex Electric Heating Company to protection of its trade-mark and its cor-

porate name afforded by the section of the statute involved is now before this Court for final determination in a proceeding which is essentially *ex parte*. It is respectfully submitted that this is a matter of such vital interest to Simplex Electric Heating Company that the interests of justice and fair play require that this motion be granted in order that it be allowed to be heard in support of its rights and in support of the decisions of the Court below.

For the above reasons it is respectfully submitted that this motion be granted and that the Simplex Electric Heating Company be added as the real party respondent at interest before this Court, and be allowed through counsel to file a brief, and make oral argument on its behalf.

Respectfully submitted,
SIMPLEX ELECTRIC HEATING COMPANY,
By NATHAN HEARD,
FREDERICK A. TENNANT,
Attorneys and of Counsel.

Service of the foregoing motion is accepted.
GEORGE L. WILKINSON,
Of Counsel for
AMERICAN STEEL FOUNDRIES,
Petitioner.

Service of the foregoing motion is accepted. The facts therein stated relating to the action and position of the Commissioner of Patents, and also as stated in paragraph 5 of the petition, are admitted to be true, and the granting of said motion is not opposed.

ALEX C. KING, Solicitor General.

FILED
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JAMES H. MCKENNEY
CLERK

Supreme Court of the United States.

October Term, 1900.

No. 181.

AMERICAN STEEL FOUNDERIES,
Petitioner,
vs.
ROBERT F. WHITRIDGE, Commissioner of Railroads,
Respondent.

On Writ of Certiorari to the Supreme Court of the State of Tennessee.

Brief for Petitioner, American Steel Foundries.

Edward Colston,
Counsel for Petitioner.

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Supreme Court of the United States.

October Term, 1920.

No. 131.

AMERICAN STEEL FOUNDRIES,
Petitioner,
v.
ROBERT F. WHITEHEAD, COMMISSIONER OF PATENTS,
Respondent.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR SIMPLEX ELECTRIC HEATING COMPANY, REAL PARTY RESPONDENT.

STATEMENT OF THE CASE.

Question Presented.

As stated in the petitioner's brief, the sole question presented by this case is the construction of section 5 of the Trademark Act of February 20, 1905.

The Facts.

The facts stated in the petitioner's brief in nine clauses on pages 2 and 3 are not disputed.

In addition it should be noted that the respondent Simplex Electric Heating Company is the successor of Simplex Electrical Company, which on October 28, 1890, obtained registration No. 18,552 for the trademark "Simplex" (see Petitioner's Brief, p. 19). While it is considered immaterial to the question at issue, it is nevertheless the fact that respondent's predecessor in business was the first ever to register this trademark "Simplex." Petitioner's brief alleges that there have been other registrations, and refers to the allegation in registration No. 56,842, issued October 23, 1906, to James Chadwick & Brother, of use of this trademark on sewing-thread since 1859 (Petitioner's Brief, p. 19), but such a statement in a registration is not even *prima facie* evidence of any date of use prior to registration. *The Rose Shoe Mfg. Co.* v. *D. A. Rosenbaum & Co.*, 28 Apps. D.C. 465. The Trademark Act, in section 16, makes only the registration itself *prima facie* evidence of ownership.

Petitioner's brief also alleges that other corporations have employed the name "Simplex," and states that such names are listed in directories, but these statements obviously are not evidence, and, moreover, it is not even alleged that such corporations, if they ever existed, are still in existence. Again such facts, even if true, are immaterial to the case at bar.

The respondent, with its predecessors, has used the name "Simplex" as a trademark ever since at least as early as October 28, 1890, as established by the registration No. 18,552, admitted by petitioner on page 19 of its brief, and has extended the use of the mark to a wide variety of articles, numbering now over seven hundred, as appeared in the case of *Simplex Electric*

Heating Company v. *Ramey Company*, and has used this mark as its name for a period beginning long prior to that date. These facts are stated, not because of their materiality to the case at bar, but to offset the incorrect atmosphere arising from the recitation of immaterial facts by the petitioner. It is interesting to notice, however, that this mark "Simplex" is in no sense the name of the petitioner, and that its predecessor, from whom it claims title to the mark, did not use it until, according to its admission, July 30, 1897, or long after its use by respondent's predecessor, both as a trademark and as a firm or corporate name.

Petitioner repeatedly alleges that it has a common-law trademark right in this mark "Simplex" for brake beams, brake shoes, and other similar devices employed on railway cars. It is true that the respondent is not at present engaged in the manufacture and sale of brakes or brake devices for railway cars. The respondent has, however, for many years supplied car heaters to railway cars, including radiators and devices used in connection therewith.

All these facts are of little consequence, however, because the sole question presented for determination here is whether the phrase—

> "Provided, that no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, . . . shall be registered under the terms of this Act"—

occurring in section 5 of the Trademark Act of Febru-

ary 20, 1905, precludes the Commissioner of Patents from registering this mark "Simplex" as a trademark to the petitioner, American Steel Foundries, for any class of goods, in view of the fact that the respondent's corporate name is Simplex Electric Heating Company.

BRIEF.

Points of Law to be Discussed.

1. The fundamental principles underlying the trademark legislation and the details of the form and substance have throughout been treated arbitrarily and inconsistently by Congress—

A. As to the fundamental principles.

B. As to the details.

2. The statutory prohibition of registry of names of persons and corporations is largely arbitrary and indiscriminatory, and is subject only to four well-defined statutory exceptions; namely:

A. In the very phrase under consideration, by permitting registry if the name is "written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual."

B. In the clause added to section 5 under consideration, by the Act of February 18, 1911, which permits registry if the mark is "otherwise registrable" and is "the name of the applicant or a portion thereof."

C. In the provisions of the so-called ten-year clause forming a part of this section 5 under consideration and permitting registry of any mark

"in actual and exclusive use as a trademark" during the ten years from February 20, 1895, to February 20, 1905.

D. In the provisions of the recent Act of March 19, 1920, granting certain limited privileges of registration.

3. The history of the trademark legislation, the judicial construction placed upon section 5 of the Act of 1905, and the amendatory and original Acts to and since the Act of 1905 established the clear intent of Congress to enact and maintain in force the clause in controversy in its ordinary, natural meaning, and thus to enforce the construction given this clause repeatedly by the Court of Appeals of the District of Columbia.

4. The Act of March 19, 1920, was for the very purpose of relieving cases like that of petitioner.

5. The word "merely" covers the salient feature of a corporate name.

6. The intention of Congress is only pertinent for consideration when the meaning of a statute is ambiguous.

7. Congress is presumed to have legislated, in reenacting or amending a statute, with knowledge of and acquiescence in prior judicial construction.

1. THE FUNDAMENTAL PRINCIPLES UNDERLYING THE TRADEMARK LEGISLATION AND THE DETAILS OF THE FORM AND SUBSTANCE HAVE THROUGHOUT BEEN TREATED ARBITRARILY AND INCONSISTENTLY BY CONGRESS.

All of the various Trademark Acts passed by Congress are based upon the principle that the property

right itself is not created by the Act, but is already in, or about to come into, existence under the common law. These Acts are all purely Registration Acts. This registration confers certain advantages upon the registrant in the matter of procedure in the courts, and in other ways, but it neither creates nor destroys any property rights in the mark itself.

The law of trademarks is but one branch, and a comparatively small branch, of the law of unfair competition in business. There are very few cases which come before the courts involving a right of action based solely on a technical trademark. Almost invariably the cases turn on the more general principles involved in the law of unfair competition.

The power of Congress to legislate upon this subject has never been determined by this court. Congress has never moved with sure footing in the matter of trademark legislation from the fundamental principles underlying the subject down to the details of the form and substance of the legislation itself.

A. As to the Fundamental Principles.

The first Trademark Act, of 1870, was passed by Congress on the theory that it had power to legislate for the registration of trademarks under the 8th clause of section 8 of the first article of the Constitution, authorizing Congress—

> "to promote the progress of science and the useful arts, by securing for limited time to authors and inventors the exclusive right to their respective writings and discoveries."

This court, in the *Trademark Cases,* 100 U.S. 82,

demonstrated the fundamental fallacy of this theory, but it is interesting to know that Congress still clings to permitting issuance of trademark registrations only "for limited times" because it started this practice under the fundamental misunderstanding that the period of registration must be limited in the same way as the monopoly conferred by patents for inventions must be limited.

The next main Act of 1881 was passed by Congress under the theory that its power was to be found in the treaty-making power conferred by section 2 of article 2 of the Constitution. Consequently for over twenty-five years the privileges of registration were absurdly restricted to commerce with the Indian Tribes and with foreign nations. Thus, during a period when the commerce of this country with the Indian Tribes and with foreign nations was negligible as compared with the vast interstate and intrastate commerce, Congress provided no means whatever for registration of trademarks employed in the only field of any consequence in this country. The constitutionality of this Act was never determined by this court.

The present Act of 1905 was passed by Congress on the theory that its powers were to be found in the famous clause of section 8 of article 1 of the Constitution giving Congress power over interstate commerce.

The history of the three main Trademark Acts thus shows that Congress has never known where it stood as to the source of its power to pass any Act at all.

B. As to the Details.

So in the details of the legislation the same uncertainty and lack of consistency appears throughout.

Congress has freely exercised in a purely arbitrary manner its undoubted right, assuming its basic powers in this field to be constitutional, to confer or deny the privileges of registration. This arbitrary exercise of power, sometimes for reasons which are apparent and sometimes for reasons which are incomprehensible, runs throughout the entire legislation. Take, for example, the so-called ten-year clause found near the end of section 5 of the present Act. By this clause, as held by this court in *Thaddeus Davids Co.* v. *Davids*, 233 U.S. 461, Congress admitted to registry marks which were not common-law or technical trademarks, but which had been in "actual and exclusive use" as trademarks for ten years next preceding the passage of the Act. This arbitrary restriction has continued to the present day, affecting only those who have used such marks for a continuous ten-year period beginning February 20, 1895. By section 9 of the Act of March 19, 1920, the privileges of this relatively small class have been still further extended. It seems to us obvious that, if there was anything fair in 1905 in conferring such a privilege upon those who had used this class of marks exclusively for ten years, the same privilege should be granted at any time to any one who at the time of application had used such a mark exclusively for ten years.

As an instance of the arbitrary exercise of power, for which there is an obvious reason, not, however, concerned with trade or commerce, sections 4 and 8 of the Act of January 5, 1905, are examples. Therein, for the purpose of protecting the American National Red Cross, the use of its symbol was prohibited as a trademark, but any person already using the symbol

at the time of the passage of the Act was permitted to continue its use.

We have called attention to this arbitrary exercise of its powers by Congress, sometimes with some apparent reason and sometimes without, because we believe it underlies a consideration of the entire Trademark Act and the particular section here in controversy.

2. THE STATUTORY PROHIBITION OF REGISTRY OF NAMES OF PERSONS AND CORPORATIONS IS LARGELY ARBITRARY AND INDISCRIMINATORY, AND IS SUBJECT ONLY TO FOUR WELL-DEFINED STATUTORY EXCEPTIONS.

The clause of section 5 of the Trademark Act under consideration has to do with a prohibition of the registry of names, descriptive words, and geographical terms, all of which are catalogued together.

It is an interesting fact, based on some peculiar psychology of the business man's mind, that a vast number, if not the vast majority, of the so-called trademarks in common use in this country are not in fact technical or common-law trademarks, but depend for their protection upon the acquisition of secondary meanings and other broader principles of the law of unfair competition. Such is the case with the "Waltham" Watch, the "Boston" Garter, "Allcocks" Porous Plaster, "Hoods" Sarsaparilla, the "Gillette" Razor, "Faber's" Pencils, "Rubberset" Brushes, "Pocahontas" Coal, to select at random from an interminable list.

It is a matter of common knowledge that the tendency is constant and frequent to adopt and use for

trademark purposes (1) a geographical term, (2) a descriptive word, or (3) an individual or proper name, to all of which the objections are obvious. Such words are essentially incapable of exclusive use.

Congress has recognized this principle and has invariably in one way or another refused registration to such marks, qualifying its refusal in special cases, such, for example, as the name of the applicant or the exclusive user of such a mark prior to February 20, 1895.

The section under consideration has to do with this third type of marks, that is, with an individual, firm, or corporate name. Litigation over these proper-name marks has been endless and bitter. Rogers, Remington, Chickering, and Brown, and many others, are well-known mileposts along the road of this unending controversy.

The great objection to the name of an individual becoming a trademark is that in its very nature it is generic and cannot be exclusive. As this court said with respect to the name "Davids," the name of the petitioner in *Thaddeus Davids Co.* v. *Cortlandt I. Davids et al.*, 233 U.S. 461:

> "As the mark consisted of an ordinary surname, it was not the subject of exclusive appropriation as a common-law trademark (Brown Chemical Co. v. Meyer, 139 U.S. 540, 542, 35 L. ed. 247, 248, 11 Sup. Ct. Rep. 625; Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118, 134, 135, 49 L. ed. 972, 984, 25 Sup. Ct. Rep. 609); and the complainant derived its right from the

fourth proviso of § 5" (commonly known as the ten-year clause).

There is no name so peculiar but that it appears to be borne by several. As Mr. Rogers says in his recent book on "Good Will, Trademarks and Unfair Trading":

> "There have been late arriving men of the name of Anargyros and Melachrino in the cigarette business, spurious Pillsburys in the flour business, personally real though commercially deceptive Fownes in the glove business. The Rogers who have been minded to go into the silver plate business are legion, Tussauds in wax works, and so on" (p. 77).

Hence the names of persons have invariably been held not to be technical trademarks, and their use, when adopted, has been protected by the courts through the principles of unfair competition. This court said in *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U.S. 118:

> "and as the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trademark, and its registration as such could not in itself give it validity."

The prohibition of the registration of the name of a person, firm, corporation, or association—that is, a personal name—is grounded on the same fundamental reason as the prohibition of the registration of a geo-

graphical term. That is, it rests upon the essential character of the mark, and has nothing to do with the character of the goods. Congress has realized and enacted that such marks are not to be given the advantages of registration, but are to be left to the protection afforded at common law and usually to the protection afforded by the law of unfair competition.

Congress, in carrying out this prohibition, and in the section under consideration, has once more assumed and exercised an arbitrary power. The same principles effecting trademark character and registration are largely true of the name of either persons, firms, corporations, or associations. But there is this difference, that a corporation, or other artificial person, may adopt either (*a*) the name of an individual, as, for example, "Remington," or (*b*) an entirely arbitrary name, as, for example, "Simplex." The former cannot be, the latter may be, a valid trademark. The distinction is perfectly clear.

But Congress, neither in the section of the Trademark Act in question, nor in any other section, has made or attempted to make this distinction. The names of persons are always treated on precisely the same basis as the names of corporations:

> "no mark which consists merely in the name of an individual, firm, corporation, or association . . . shall be registered."

The only exceptions which Congress has made to this prohibition of the registry of such marks are—

> A. In the very phrase under consideration, by permitting registry if the name is "written,

printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual."

B. In the clause added to section 5 under consideration, by the Act of February 18, 1911, which permits registry if the mark is "otherwise registrable" and is "the name of the applicant or a portion thereof."

C. In the provisions of the so-called ten-year clause forming a part of this section 5 under consideration and permitting registry of any mark "in actual and exclusive use as a trademark" during the ten years from February 20, 1895, to February 20, 1905.

D. In the provisions of the recent Act of March 19, 1920, granting certain limited privileges of registration.

In this respect Congress is well within its powers. Registration at best is but a *privilege* granted by Congress, and it is within the power of Congress to grant it to such extent and to such classes of marks or persons as it may please. If property rights exist in a mark, that fact alone does not entitle the owner of such rights to registration of the mark. The right to register is purely statutory and within the power of Congress, for any reason whatever, to grant or to withhold.

3. THE HISTORY OF THE TRADEMARK LEGISLATION, THE JUDICIAL CONSTRUCTION PLACED UPON SECTION 5 OF THE ACT OF 1905, AND THE AMENDATORY AND ORIGINAL ACTS TO AND SINCE THE ACT OF 1905 ESTABLISHED THE CLEAR INTENT OF CONGRESS TO ENACT AND MAINTAIN IN FORCE THE CLAUSE IN CONTROVERSY IN ITS ORDINARY, NATURAL MEANING, AND THUS TO ENFORCE THE CONSTRUCTION GIVEN THIS CLAUSE REPEATEDLY BY THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

The purpose and intent of Congress is best ascertained by briefly reviewing what it has actually done in legislating upon the registration of these name marks with which this controversy is concerned.

The first Trademark Act passed by Congress, namely, the Act of 1870, which was entitled: "An Act to Revise and Consolidate and Amend the Statutes Relating to Patents and Copyrights," provided, in section 79:

> "The Commissioner of Patents shall not receive and record (1) any proposed trademark which is not and cannot become a lawful trademark, (2) or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, (3) or which is identical with the trademark appropriated to the same class of merchandise and belonging to a different owner and already registered or received for registration, (4) or which so nearly resembles such last mentioned trademark as to be likely to deceive the public. Provided, that this section shall not prevent the registry of (5) any lawful trademark

rightfully used at the time of the passage of this Act."

It is to be noted that geographical terms and descriptive words were not specifically mentioned, but were prohibited registry under clause (1) as marks which were not and could not become lawful trademarks.

It is to be noted further that the language prohibiting registry for person and corporate names is substantially the same as in section 5 of the present Act.

Under clause (1) of this section 79 geographical terms and descriptive words were refused registration in a long line of cases by the Commissioner. See Hopkins on Trademarks, Trade Names, and Unfair Competition, p. 506, note 25.

Under this section, clause (2), the names of persons were refused registration. For example, in *In re Consolidated Fruit Jar Co.*, 14 O.G. 279, the Commissioner refused registration of the name "Mason" for the well-known fruit jar, first, because it was clearly prohibited by the statute as "the name merely of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish it," etc., and second, because, although it had been in use by the applicant long prior to the passage of the Act, it did not come within the proviso permitting registration to "any lawful trademark rightfully used at the time of the passage of this Act," since it was the well-known and common designation of the jar, upon which the patent had expired. It is to be noted in this case that this name "Mason" was not the name of the applicant, Consolidated Fruit Jar Company, but the name of the in-

ventor of the jar. This decision was on December 20, 1878, and while, a little later on, just before the passage of the Act of 1881, the Commissioner by main strength read into the Act a limitation to the prohibition of the registration of the name of a person, firm, or corporation to that of the applicant, as stated in petitioner's brief (p. 33), this was not the construction of the Act during most of the period it was in force. In the October Term of 1879 this court, in *Steffens et al.* v. *United States,* 100 U.S. 82, held this Act unconstitutional, and, so far as we have ascertained, no judicial construction was ever given by the courts to the clause in question.

The Act of 1881 was passed by Congress after the decision of this court in 100 U.S. 82. The House Committee on the Judiciary reported on a bill providing for the registration of trademarks in foreign and interstate commerce under the authority of the commerce clause of article 1, section 8, of the Constitution, and also upon a proposed amendment to the Constitution giving the Congress "power to grant, protect, and regulate the exclusive right to adopt and use trademarks." In this report, No. 561, 46th Congress, 2d Session, the committee held that Congress had no power to pass such a bill under section 8, article 1, of the Constitution, and that trademarks were "mere contracts of indemnity against loss by fraud," and that Congressional control did not extend to them any more than to policies of insurance, held to be without the power of Congress to regulate in *Paul* v. *Virginia,* 8 Wall. 168. The report also was unfavorable to the passage of an amendment to the Constitution. The report concluded by recommending the passage of a

bill confined to commerce with the Indian Tribes and foreign nations and based upon the treaty-making power conferred by section 2 of article 2 of the Constitution. An amended or substitute bill finally became the Act of 1881.

Thus Congress deliberately decided to refuse registration to all legal *bona fide* technical trademarks used only in interstate commerce. Such trademarks constituted the bulk of those in use, and the Act was thereby rendered of little value to the commercial interests of this country. This condition continued for over twenty-five years, but no one for a moment questions the power of Congress, if it had any power at all, thus to restrict registration, nor the fact that it did.

This Act of 1881, in section 3, provided:

> "But no alleged trademark shall be registered unless . . . nor which is merely the name of the applicant."

This Act therefore changed the prohibition contained in the Act of 1870, refusing to register the name of a person, firm, or corporation, *whether the applicant or not,* to a prohibition limited only to the case where the name was that of the applicant, possibly being influenced by the then recent decision of the Commissioner of Patents. It is interesting to note that in this respect the Act of 1881 specifically *refused* registration to the name of the applicant, while in the existing Act such a name of the applicant is specifically *permitted* registration.

The Act of 1881 originally contained no provision, as did the Act of 1870, permitting registration of any lawful trademark rightfully used by the applicant at

the time of the passage of the Act, but this omission was cured by the amendatory Act of August 4, 1882.

This prohibition in the Act of 1881 as to the registration of a mark "which is merely the name of the applicant" was strictly enforced by the Commissioner of Patents.

See *In re Fairchild,* 21 O.G. 789, wherein the Commissioner refused to register "Fairchild," although it had been registered under the Act of 1870 and had been in use as a trademark for over twenty years.

Ex parte Creedmore Cartridge Co., 56 O.G. 1332, wherein registration was refused the name of the applicant.

Ex parte Adriance, Clapp & Co., 20 O.G. 1820, refusing to register the word "Adriance."

Ex parte Buffalo Pitts Co., 89 O.G. 2069, refusing to register "Buffalo Pitts," because:

> "The word 'Pitts' is an ordinary surname and a salient feature of *applicant's name,* while the word 'Buffalo' is a geographical term and also a part of *applicant's name.* That ordinary surnames and geographically descriptive words are not registrable is now too well settled to admit of any controversy."

Ex parte Edwin C. Burt Co., 96 O.G. 1430, wherein the applicant company and its predecessors had used the name "Burt" since 1860. In his decision refusing registry the Commissioner said:

> "A technical trade mark is essentially a vested right. A proper name is not a technical trade mark for the very reason that in the nature of

> things it never was and never can be a vested right. It belongs equally to all persons bearing that name. This doctrine was as well settled prior to 1881 as it is at the present time."

The Act of 1905, now in force, as already noted, in section 5 under consideration, provides:

> "that no mark which consists merely in the name of an individual, firm, corporation, or association, . . . shall be registered."

At the time of the passage of the Act the only exceptions to this definite prohibition were two of those four noted above on pages 12, 13; namely:

> A. In the very phrase under consideration, by permitting registry if the name is "written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual."
>
> C. In the provisions of the so-called ten-year clause forming a part of this section 5 under consideration and permitting registry of any mark "in actual and exclusive use as a trademark" during the ten years from February 20, 1895, to February 20, 1905.

With the law thus, the question of the right to register the salient feature of a corporate name arose in a case where the name was that of the applicant. The mark was the term "Old Lexington Club" for whisky, and the applicant's name was Old Lexington Club Distilling Company. In this case the Court of Appeals of the District of Columbia said:

"There are several provisions of the statute, which, we think, forbid the registration of the mark, in question. Section 5 of the act of Congress of February 20, 1905, among other things [quoting the section under consideration].

"It will be observed that the trade-name here sought to be registered is almost a reproduction of the corporate name of the applicant. In fact, it seems probable, from an examination of the record in this case, that the corporate name of the appellee company was derived from the mark sought to be registered, since 'Old Lexington Club' was a name applied to liquor distilled and sold by the predecessors in business of appellee" (*Kentucky Distilleries & Warehouse Co.* v. *Old Lexington Club Distillery Co.*, 31 Apps. D.C. 223).

The decision of the Court of Appeals in the Old Lexington Club case was followed by the Commissioner in a number of cases; for example, *Ex parte Champion Safety Lock Company*, 143 O.G. 1109, wherein the Commissioner refused on the authority of that case to register the mark "Champion" on the ground that it was merely the name of the applicant corporation.

The same question again came before the Court of Appeals in the case of *In re The Success Company*, 34 Apps. D.C. 443, wherein the mark "Success," for which registration was sought, was held by the court to be the "dominant feature of the corporate name." In construing the statute the court said:

"The word 'merely', as used in the statute, was clearly intended to prevent the registration

> by a corporation of its own name, whether that name be the subject of a technical trademark or not. We must take the statute as we find it and attempt to enforce its plain provisions."

These decisions finally led to the amendatory Act of February 18, 1911. Congress had the matter directly called to its attention as appears from the report of the Committee on Patents to the House and Senate (see House Report No. 1097, 61st Congress, 2d Session), wherein it was stated:

> "The Court of Appeals of the District of Columbia has held that said section 5 as the same now stands has the effect 'to prevent the registration by a corporation of its own name, whether that name be the subject of a technical trademark or not.' "

In amending the Act Congress made no attempt, and indicated no purpose, to limit the prohibition of the statute preventing the registration of the name of a person, firm, corporation, or association other than with respect to the applicant. The amendment, which is now embodied in this section, reads:

> "Provided further, that nothing herein shall prevent the registration of a trademark otherwise registrable because of its being the name of the applicant or a portion thereof."

The purpose of Congress in the Trademark Act to exercise its power arbitrarily and without regard to any rules of technical trademark law was again evidenced by the amendment to this section of January

8, 1913. This arose through the attempt of John M. Given, Inc., to register as a trademark for hosiery the word "Wingedfoot" and the conventional representation of the winged foot of Mercury. This was the well-known emblem of the New York Athletic Club, which was in no sense a commercial or trading organization, but which opposed registration. While the opposition was pending, this amendment was speedily passed by Congress, and under the provisions of the amendment registration was refused. See *N.Y. Athletic Club* v. *John M. Given, Inc.*, 4 T.M. Rep. p. 172. This amendment prevents registration—

> "of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any state in the United States prior to the date of adoption and use by the applicant," etc.

It was the object of Congress by this amendment to protect the emblem, flag, or other distinguishing mark of any institution, organization, club, or society just as it was to protect any corporate name in the section under consideration. No limitations were imposed other than, in the particular case of an institution, organization, club or society, that it must have been incorporated prior to the date of adoption and use by the applicant. This amendment was not unlike the prior Act of 1906, protecting the mark of the American Red Cross.

Early in 1914 the case of *Asbestone Co.* v. *The Carey Mfg. Co.*, 41 Apps. D.C. 507, came before the Court of Appeals for the District of Columbia, the final

appellate authority provided by section 9 of the Act. Therein the Carey Manufacturing Company sought registration for the mark "Asbestone" for hard asbestos boards. The Asbestone Company opposed registration under the provisions of the clause of section 5 in controversy, stating no trademark use on its part of the word "Asbestone," but relying upon its name. The matter came up on a motion to dismiss, in the nature of a demurrer, so that the question was squarely raised, and the court refused registration, saying:

> "The Statute takes from the realm of possible registration the name of an individual, firm, corporation or association, except under conditions not existing in this case. This limitation is founded upon sound principles of public policy."
>
> "It is not the business which the Statute in this particular instance aims to protect, it is the corporate name, and it is sufficient that possible damage may be incurred from invading the property right which the corporation possesses in its name."

Thus the court followed the plain language of the Act and refused to register as a trademark to the Carey Manufacturing Company the word "Asbestone," which was the prominent feature of the name of another corporation, *i.e.,* the Asbestone Company.

The same point again arose in the case of *In re United Drug Company,* 44 Apps. D.C. 209, wherein the court sustained the Commissioner in refusing registration of the mark "Stork" as a trademark for rubber nipples, applied for by United Drug Company, in view of the corporate name "The Stork Company."

Later followed the cases of *Mansfield Tire & Rubber Company* v. *Ford Motor Company*, 44 Apps. D.C. 205, where the court affirmed the Commissioner in refusing registration of the word "Ford" solely upon this ground, and the cases of *D. H. Burrell & Company* v. *Simplex Electric Heating Company*, 44 Apps. D.C. 452; *Simplex Electric Heating Company* v. *Ramey Company*, 46 Apps. D.C. 400; and *In re American Steel Foundries*, Record, p. 23, wherein the court refused registration to various corporations of the mark "Simplex" because of respondent's corporate name, "Simplex Electric Heating Company."

Thus for many years the Court of Appeals of the District of Columbia, charged by the Act of 1905 itself with final appellate authority, has uniformly, repeatedly, and consistently construed the clause of section 5 under consideration to mean just what it says, and refused to read into this clause any exceptions to the names of persons, firms, corporations, or associations other than those provided by the Act itself and the amendments thereto.

During this long period the matter has been repeatedly brought to the attention of Congress, and Congress has amended the Act in the particulars which we have noted. The intent of Congress, therefore, to maintain the construction of this clause placed upon it by the Court of Appeals of the District of Columbia has been clearly evidenced.

4. The Act of March 19, 1920, was for the very purpose of relieving cases like that of petitioner.

The last and recent action of Congress in this matter appears in the Act of March 19, 1920. For many years

there has been a considerable protest by the business interests of the country because of the failure of the Trademark Act to provide for the registration of many marks which were registrable under the laws of foreign countries. As many foreign countries permit registration to foreigners only in case of marks registered in the country of origin, the limitations of the United States Trademark Act, such as in the clause in question, prevented registration in foreign countries.

This inability to secure foreign registrations for marks used in the United States but incapable of registration under the Trademark Acts, either (1) because they were not valid common-law trademarks or (2) because they were not registrable under the provisions of the Trademark Act, such as the one in controversy, has unquestionably had its disadvantages, but this is no reason for distorting the meaning of the Act. The remedy is with the legislature, not with the courts.

The position of the Patent Office has been clearly stated by Mr. J. H. Carnes, the able Examiner of Trademarks, in a recently published paper, as follows:

> "It is a prerequisite to such foreign registration, under the statutes of almost all foreign countries, that the applicant shall first obtain a registration in his own country. In such cases federal registration, therefore, becomes vitally important. If it so happens that the nature of the mark is such that registration is prohibited by any of the provisions of section 5 of the Trade-Mark Act of February 20, 1905, the applicant for registration generally seeks to have the provisions of this section stretched and distorted out of all

> recognition. The Office has, however, held in effect, in at least one instance, that the necessity of the applicant is no good and sufficient reason for judicial legislation by the Office. (Ex parte Buffalo Pitts Company, 89 O.G. 2069.)"

These attempts, at what we respectfully submit is a distortion of the meaning of the Act, have been repeatedly made. Such was the recent litigation over the mark "Infallible" for powder, which was refused registration as "merely descriptive" by the Patent Office, by the Court of Appeals of the District of Columbia, and then, in a suit under the provision of section 4915, R.S., by the District Court for the Southern District of New York and the Circuit Court of Appeals for the Second Circuit. The last court in concluding its opinion said:

> "It is also reasonably inferable from this record that plaintiff feels unjustly treated by refusal to register a word which it has exclusively and successfully used as a trade-mark for more than ten years, but not for that decade which alone secures protection under the ten-year clause of the present statute. We appreciate the hardship and are quite aware of the international trade-mark difficulties which beset the path of the American trader in foreign parts who has not secured registration in his own country. But the remedy is with the Congress, and neither the Commissioner of Patents nor any court can change the accepted law on which the Trade-Mark Act of 1905 was built.
>
> . . . . . .

> "There is much to be said in favor of a registration law which would give legal and governmental sanction to any mark which it could be shown the public had accepted. Such a system would enable this plaintiff to prevail; but Congress must first create it." *Hercules Powder Co.* v. *Newton, Commissioner,* 266 Fed. 169.

The recent Trademark Act of March 19, 1920, when first introduced as a bill and reported on by the House Committee on Patents (see House Report No. 411, 66th Congress, 1st Session), was for the sole purpose of giving effect to the Convention between the United States and the Central and South American States and Cuba for the protection of trademarks. When the bill came before the Senate it was amended (see Senate Report No. 432, 66th Congress, 2d Session) to include the present clause *b* in section 1. The purpose of this as stated by the report was—

> "in order to get protection for American citizens in foreign countries other than those covered by"—

the House Bill, which only contained paragraph *a* of the present Act. The Senate Report stated the purpose of the entire Act to be as follows:

> "It is simply for the purpose of enabling manufacturers to register their trade-marks in this country for the purpose of complying with legislation in foreign countries, which necessitates registration in the United States as a necessary preliminary for such foreign registration. As

> the law now stands, it enables trade-mark pirates in foreign countries to register as trade-marks, the names and marks of the American manufacturers, and thus levy blackmail upon them."

As we have already pointed out, the only reason given for the issuance of a writ of certiorari in the petition therefor was that the construction placed upon this clause of the statute by the Court of Appeals of the District of Columbia prevented the petitioner and others similarly situated from registering their alleged trademarks in foreign countries where registration first in the United States was a prerequisite. Petitioner now admits that section *b* permits the registration of its mark. Petitioner's brief states—

> "Section (b) has been construed by the solicitor of the Department of the Interior to mean that the Commissioner may register certain trademarks which are prevented from registration by various provisos contained in schedule (b) of Section 5 of the Act of 1905" (Brief, p. 38).

Petitioner's proposition now is that the *kind* of registration which Congress has provided for it and which is the final demarcation up to date by Congress of the privilege of registration for these name marks is not satisfactory to petitioner.

But, as petitioner practically admits on page 37 of its brief, this Act of 1920 is for the very purpose of relieving such situations as that in which the petitioner finds itself, and defines the only kind of registration Congress is willing to grant to such a mark.

Summary on Point 4.

We submit that the history of the trademark legislation which we have thus outlined, the judicial construction placed upon the section in controversy, and the amendatory and original Acts to and since the Act of 1905 establish the clear intent of Congress to enact and maintain in force the clause in controversy in its ordinary natural meaning, to enforce the construction to this effect given this clause repeatedly by the Court of Appeals of the District of Columbia, and thus to prohibit the registration of these name marks, that is, the "mere name of a person, firm, corporation or association," subject only to the four exceptions already noted; namely:

A. In the very clause under consideration, by permitting registry if the name is "written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual."

B. In the clause added to section 5 under consideration, by the Act of February 18, 1911, which permits registry if the mark is "otherwise registrable" and is "the name of the applicant or a portion thereof."

C. In the provisions of the so-called ten-year clause forming a part of this section 5 under consideration and permitting registry of any mark "in actual and exclusive use as a trademark" during the ten years from February 20, 1895, to February 20, 1905.

D. In the provisions of the recent Act of March 19, 1920, granting certain limited privileges of registration.

5. THE WORD "MERELY" COVERS THE SALIENT FEATURE OF A CORPORATE NAME.

The petitioner has much to say with reference to the word "merely," employed in the clause of the Act under consideration, which strikes us as without force, if not as a mere quibble.

In this age and in this country no person has but a single word in his name and no corporation has but a single word in its name. If this is not absolutely true, we have never heard of the exception.

So also it is most ordinary and common for several persons to bear the same names throughout. This is true not only of the John Smiths, but of the most unusual names.

So again it is most ordinary and common for corporations to bear the same names where forty-eight different states are granting charters by the thousands.

The name of every corporation is composed of more than one word. The petitioner's name is an exception to the general rule, frequently embodied in the statutes, that the name of a corporation shall include some word to show that it is a corporation, such as "Company" or "Incorporated." Usually or frequently the corporate name contains some characterizing or distinguishing word, such as "American," as in the case of petitioner, or "Simplex," as in the name of respondent; and some one or more words indicating the general nature of the business, such as "Steel Foundries," as in the case of petitioner, and "Electric Heating," as in the case of respondent.

No serious contention can be made that, in the long line of Trademark Acts, including the one now in force, which prohibit the registration of a mark consisting

"merely in the name of a . . . corporation," the prohibited mark must include each and every word in the corporate name, and no such construction has ever been placed upon the Act. The cases to which we have already referred are sufficient illustrations. Without repeating them all, we note, for example, "Adriance" was held merely the name of Adriance, Clapp & Company; "Gilson" merely the name of F. H. Gilson Company; "Old Lexington Club" merely the name of Old Lexington Club Distilling Company; "Champion" merely the name of Champion Safety Lock Company; "Success" merely the name of The Success Company; "Ford" merely the name of Ford Motor Car Company.

The amendment to the Act of February 18, 1911, is a distinct ratification by Congress of this construction of the clause in question. It will be remembered that the object Congress had in mind was by amendment to prevent the prohibitory clause in question from denying registration to the applicant's own name, as had been done in *Ex parte Champion Safety Lock Company, supra,* and *In re The Success Company, supra,* and other cases.

The use of the words "or a portion thereof" in the amendatory Act, which reads:

> "That nothing herein shall prevent the registration of a trademark otherwise registrable because of its being the name of the applicant or a portion thereof"—

shows that the Act, in the clause in question—

> "merely in the name of a person, firm, corporation or association," etc.—

prevented, in the opinion of Congress, the registration of a word which formed a portion only of a corporate name. Nowhere else in the Act, except in the clause in question, was there anything requiring this language. It was a plain statement by Congress that "merely in the name . . . of a corporation" in the clause in question prevented registration of the entire corporate name or a portion thereof, whether the corporate name was that of the applicant or of any other corporation.

The Principles of Statutory Construction Applicable.

6. THE INTENTION OF CONGRESS IS ONLY PERTINENT FOR CONSIDERATION WHEN THE MEANING OF A STATUTE IS AMBIGUOUS.

While much has been said herein with respect to the intent of Congress as to the prohibition contained in the clause of the Act in question, the clause itself is, we think, perfectly clear and definite. If this be so, there is no need to look for the intention of Congress, because such intention is only pertinent for consideration when the meaning of the statute is ambiguous. This principle was clearly laid down by this court in *Bate Refrigerator Company* v. *Sulzberger*, 157 U.S. 136, in the following language:

> "In our judgment the language used is so plain and unambiguous that a refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress. But, as declared in Hadden v. Collector, 5 Wall. 107, 111, 'what is termed the policy

> of the government with reference to any particular legislation is generally a very uncertain thing, upon which all sorts of opinions, each variant from the other, may be formed by different persons. It is a ground much too unstable upon which to rest the judgment of the court in the interpretation of statutes.' 'Where the language of the act is explicit', this court has said 'there is great danger in departing from the words used, to give an effect to the law which may be supposed to have been designed by the legislature. . . . It is not for the court to say, where the language of the statute is clear, that it shall be so construed as to embrace cases, because no good reason can be assigned why they were excluded from its provision.' Scott v. Reid, 10 Pet. 524, 527."

Long ago this court announced this principle in *Minor et al.* v. *The Mechanics Bank,* 1 Pet. 46:

> "The ordinary meaning of the language must be presumed to be intended, unless it would manifestly defeat the object of the provisions."

Again, referring to an Act which this court found "plain on its face, and single in its purpose," this court said, in *Lessee of French et al.* v. *Spencer et al.,* 21 How. 228:

> "And, then, what is the rule? One that cannot be departed from without assuming on part of the judicial tribunals Legislative power. It is, that when the Legislature makes a plain provision, without making any exception, the courts can make none" (citing many cases)—

or as this court said, in *Yturbide's Executors* v. *United States*, 22 How. 290:

> "If there be no saving in a statute, the court cannot add one on equitable grounds."

That the enforcement of this principle of statutory construction may even be quite opposed to, or go far beyond, the probable intention of Congress was made clear by this court in the so-called White Slave case, from which we quote a few paragraphs:

> "It is elementary that the meaning of a statute must, in the first instance, be sought in the language in which the act is framed, and if that is plain, and if the law is within the constitutional authority of the law-making body which passed it, the sole function of the courts is to enforce it according to its terms. Lake County v. Rollins, 130 U.S. 662, 670, 671; Bate Refrigerating Co. v. Sulzberger, 157 U.S. 1, 33; United States v. Lexington Mill Co., 232 U.S. 399, 409; United States v. Bank, 234 U.S. 245, 258.
>
> "Where the language is plain and admits of no more than one meaning the duty of interpretation does not arise and the rules which are to aid doubtful meanings need no discussion. Hamilton v. Rathbone, 175 U.S. 414, 421. There is no ambiguity in the terms of this Act.
>
> "But, as we have already said, and it has been so often affirmed as to become a recognized rule, when words are free from doubt they must be taken as the final expression of the legislative intent, and are not to be added to or subtracted

from by considerations drawn from titles or designating names or reports accompanying their introduction, or from any extraneous source. In other words, the language being plain, and not leading to absurd or wholly impracticable consequences, it is the sole evidence of the ultimate legislative intent. See Mackenzie v. Hare, 239 U.S. 299, 308.

"The fact, if it be so, that the Act as it is written opens the door to blackmailing operations upon a large scale, is no reason why the courts should refuse to enforce it according to its terms, if within the constitutional authority of Congress. Such considerations are more appropriately addressed to the legislative branch of the government, which alone had authority to enact and may if it sees fit amend the law. Lake County v. Rollins, supra, p. 673." *Caminetti* v. *United States*, 242 U.S. 470.

We respectfully submit that the language of the clause in question is plain, definite, and clear. It might have been a wiser provision for Congress to have distinguished between those corporate names which included an ordinary surname and those which included an arbitrary word capable of being a valid trademark. It might have been a wiser provision, as the Court of Appeals of the Second Circuit said in *Hercules Powder Co.* v. *Newton, Commissioner, supra,* for Congress to have given legal and governmental sanction to any mark which it could be shown the public had accepted. But Congress did neither of these things, but plainly and definitely prohibited in the present Act, as it had

done in past Acts, the registration of personal, firm, corporation, and association names of whatever nature and composition. No exception was made except in the four specific clauses in the original and amendatory Acts to which we have called attention, and we respectfully submit that, if further exceptions are to be made, they must be made by Congress, and not by this court.

7. CONGRESS IS PRESUMED TO HAVE LEGISLATED, IN RE-ENACTING OR AMENDING A STATUTE, WITH KNOWLEDGE OF AND ACQUIESCENCE IN PRIOR JUDICIAL CONSTRUCTION.

Another principle which we think is here applicable is that, where a statute has been re-enacted or, we take it, amended, leaving unchanged a clause which has been construed by the courts or been subject to an established executive construction, Congress is presumed to have legislated, in re-enacting or amending the statute, with knowledge of and acquiescence in the prior judicial or executive construction.

This principle as applied to executive or departmental construction was recently thus stated by this court in *National Lead Company* v. *United States*, Adv. Ops. April 1, 1920, No. 11, p. 269:

> "The re-enacting of the drawback provision four times, without substantial change, while this method of determining what should be paid under it was being constantly employed, amounts to an implied legislative recognition and approval of the executive construction of the statute (United States v. Philbrock, supra; United States v. Falk, 204 U.S. 143, 152, 51 L. Ed. 411, 414, 27 Sup. Ct.

Rep. 191; United States v. Cerecedo Hermanos y Campañia, 209 U.S. 337, 52 L. ed. 821, 28 Sup. Ct. Rep. 532), for Congress is presumed to have legislated with knowledge of such an established usage of an executive department of the government (United States v. Bailey, 9 Pet. 238, 256, 9 L. ed. 113, 120)."

This principle was recently thus stated by the Circuit Court of Appeals for the Second Circuit in *Edwards* v. *Wabash Railway Company,* 264 Fed. 610:

> "It is a familiar and well-established rule that, where a statute that has been construed by the courts has been re-enacted in the same or substantially the same terms, the Legislature is presumed to have been familiar with its construction, and to have adopted it as a part of the law, unless a different intention is indicated."

In the case of *The Dollar Savings Bank* v. *United States,* 19 Wall. 227, 237, this court referred to this principle, saying:

> "It is, doubtless, a rule that when a judicial construction has been given to a statute, the reenactment of the statute is generally held to be in effect a legislative adoption of that construction."

In that case this court was considering the decisions of the Internal Revenue Commissioner, and held that they could hardly be denominated judicial constructions, and that their character was such that there was—

"no presumption that his decisions were brought

> to the knowledge of Congress when the Act of 1870 was passed."

In the case at bar, on the contrary, it affirmatively appears that the interpretation placed upon the clause in question was directly brought to the attention of Congress, and in view thereof Congress, by the Act of February 18, 1911, amended the statute so as to afford relief, and relief only, in the case of the name of the applicant leaving the statute as construed by the court otherwise unchanged.

The same principle was again stated by this court in the case of *The Abbotsford*, 98 U.S. 440, 444:

> "From this it is apparent that when the act of 1875 was passed, words in a statute limiting the power of this court in the review of cases where the facts had been found below 'to a determination of the questions of law arising upon the record and to the rulings of the court excepted to,' had acquired, through judicial interpretation, a well-understood legislative meaning, and that they confined our jurisdiction to the re-examination of questions of law alone. Having that meaning, therefore, it is to be presumed they were used in that sense in this instance, unless the contrary is in some way made to appear. So far from there being any manifestation of such a contrary intention, the reverse is very clearly indicated."

SUMMARY.

1. The Court of Appeals of the District of Columbia has correctly construed section 5 of the Act of 1905.

2. This section 5 prohibits petitioner from registering the word "Simplex" under the Act of 1905.

3. The only registration permitted petitioner is under the Act of 1920.

CONCLUSION.

It is therefore respectfully submitted that the decision of the Court of Appeals for the District of Columbia should be affirmed.

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BOSTON, November 29, 1920.